

In the Supreme Court of the United States

ON WRIT OF HABEAS CORPUS

No. 337

THE TINKLEBERRY ARMS COMPANY

Petitioner

vs.

CLEVELAND STEEL PRODUCTS CORPORATION

Respondent.

PETITION FOR A WRIT OF HABEAS CORPUS

To the United States Circuit Court of Appeals

For the Sixth Circuit

BRINT H. BROWN, Clerk

Respectfully submitted,

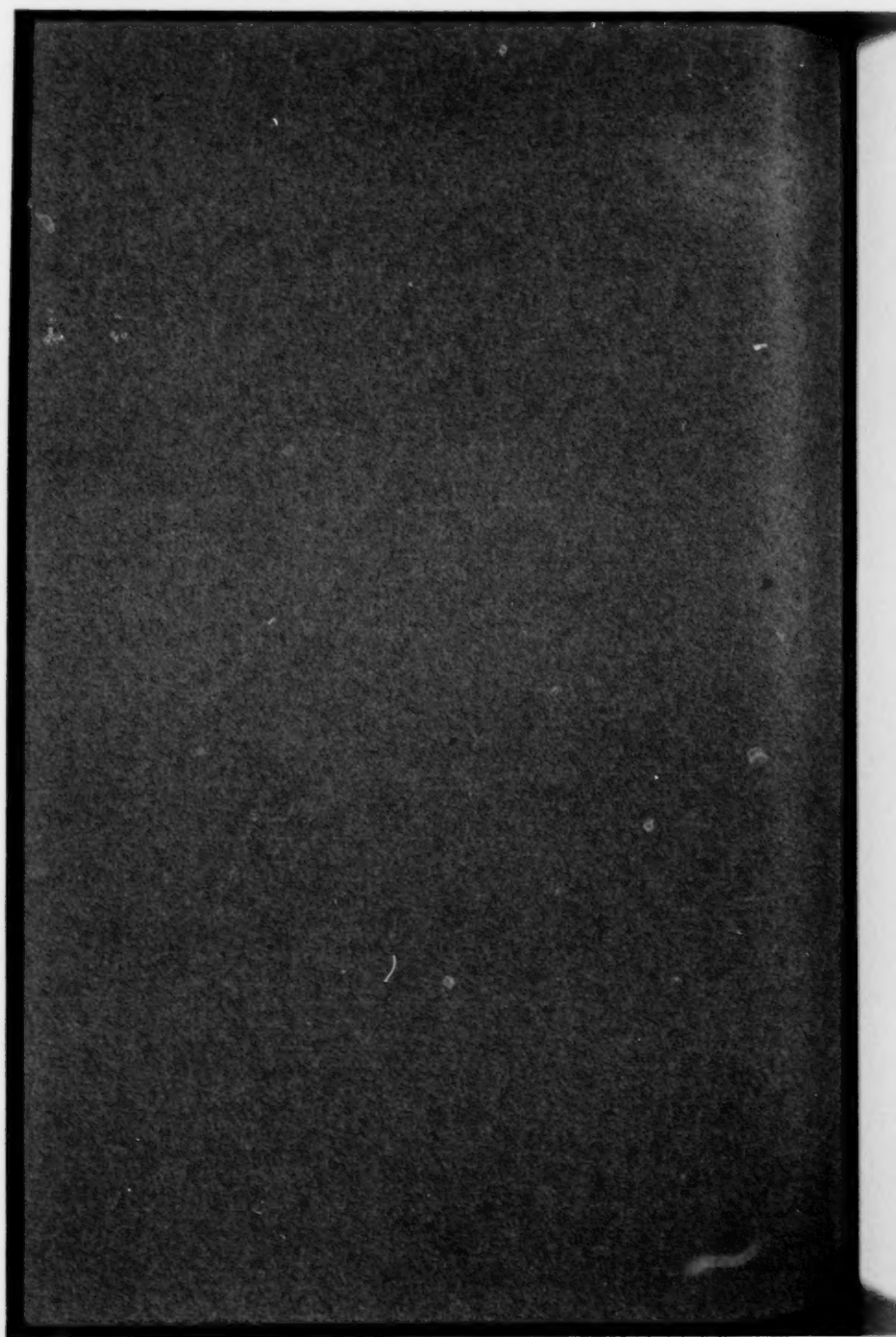
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In the Supreme Court of the United States

OCTOBER TERM, 1944.

No.

THE TIMKEN-DETROIT AXLE COMPANY,
Petitioner,

vs.

CLEVELAND STEEL PRODUCTS CORPORATION,
Respondent.

PETITION FOR A WRIT OF CERTIORARI
To the United States Circuit Court of Appeals
For the Sixth Circuit.

To the Honorable Harlan F. Stone, Chief Justice of the United States, and the Associate Justices of the Supreme Court of the United States:

Your Petitioner, The Timken-Detroit Axle Company, respectfully prays for a Writ of Certiorari to the Circuit Court of Appeals for the Sixth Circuit to review the Judgment of that Court entered March 5, 1945 (Vol. II, p. 1071) in a suit for unpaid royalties and alleged infringement of three patents (Rehearing denied after corrections of the Opinion, April 13, 1945) affirming the decree of the District Court for the Northern District of Ohio, Eastern Division (Vol. II, R. p. 1061; 52 F. S. 317) and directing that the Bill of Complaint (R. p. 2) be dismissed on the infringement cause. Defendant was ordered to pay the unpaid royalties so that the claim is not presented in this Petition.

A transcript of the record in the case, including the proceedings of said Circuit Court of Appeals, has been furnished in accordance with the rules of this Court.

A.

SUMMARY STATEMENT OF MATTERS INVOLVED.

This cause included (a) a claim for unpaid royalties under a license and (b) a claim of patent infringement; each claim was based on the same defendant's construction. The three patents relied upon related to oil burners involving chemical, physical, fuel combustion and other problems and the solution thereof. Both Courts held infringement (defendant duplicated plaintiff's commercial construction). Both Courts decided the license issue in plaintiff's favor.

The Patent Office held the disclosure in each of the three patents to be sufficient and to comply with the Statutes. The District Court held all three disclosures insufficient and the Court of Appeals held the disclosure of the first patent insufficient.

The Patent Office held all three patents to disclose invention on the same art which was before the Courts, including the art selected by the defendant's expert, as the best art, which was fully discussed in the Patent Office in *ex parte* and *inter partes* proceedings.

The conclusions of the Patent Office were supported and affirmed by the evidence in the record proving the presence of objective tests on the basis of which the District Court found that there was a "problem," that the patentee made "a great contribution" to the solution of the problem, which was accepted by the public as a solution, accompanied by commercial success and the taking of the license by the defendant. The District Court was obliged to select features from not less than six and, in fact, as many as ten, different prior art devices to find the combinations in the claims, and hold lack of patentable invention. The District Court found that there had been a change in shape, size, dimensions, material and arrangement of parts.

On these subjects the District Court said (Vol. II, pp. 1063-1064):

"The evidence convinces the court **that there was a problem, that the plaintiff made a great contribution to the solution of the problem**, an improvement in oil burners that **was accepted by the public** and had commercial success. The defendant itself took a temporary license." (Emphasis ours throughout this brief unless otherwise indicated.)

and (Vol. II, p. 1065):

"True, as plaintiff says, 'there has been a change in *the shape and in the size and dimensions * * * and differences in the relation to each other of the parts,*'."

and the District Court found (Vol. II, p. 1067):

"8. *Some of the features of the claimed inventions are disclosed in the Heath patent, some in the Bird patent, some in the Kolva patent, some in the Braun patent, some in Exhibit DXM, and some in Exhibit DXN, and were to the extent of such disclosure anticipated by such patents.*"

* * * * *

"6. There was a problem and plaintiff made a contribution to the solution of the problem, an improvement in oil burners that was accepted by the public and had commercial success."

The evidence shows that the "great contribution to the solution of the problem" referred to by the District Court included production of a furnace which eliminated the destructive and dangerous explosions or reduced them to a negligible minimum which heated and cooled quickly, whose efficiency and durability were increased, whose carbon deposits were reduced, oil cracking eliminated, which could burn heavier and cheaper oils and in which the service was reduced.

The record of the Court of Appeals shows a tremendous decline in the sustaining of patents in recent years, as we show *post* (p. 12), which would influence, and we think dominate, the views of a District Judge and naturally lead him to such a conclusion in spite of the evidence and the established law to the contrary.

The Court of Appeals held the first patent to be insufficient in description and then said "if we are wrong" in this finding then we affirm "for other infirmities in patentability."

Among the errors in the opinion of the Court of Appeals were its rulings upon issues not before the Court requiring the Court to issue a special order thirty days subsequent to the filing of the Court's opinion, which corrected some, but not all, of these procedural errors (Vol. VI, pp. 57-58).

The questions presented before this Court are questions of law and appeals to this Court to resene the inventing public and the patent bar from the confusion which has resulted from misunderstandings of the opinions of this Court and which has resulted in a most deplorable and alarming decline in patent applications filed, patents granted and inventions made in the United States in the last ten or fifteen years, as shown by data and curves which we supply hereinafter.

B.

REASONS RELIED UPON FOR ALLOWANCE OF THE WRIT.

(1) Conflict and confusion among and between the rulings and opinions of the Court of Appeals, the District Court and the Patent Office on the same issues, including (A) "sufficiency of disclosure" and (B) "invention or mechanical skill" over the same prior art as was before the Patent Office.

(2) Confusion among all patent Tribunals below regarding such questions as "invention and mechanical skill" and "sufficiency of disclosure" which has arisen since the institution of certain alleged "doctrinal trends," including "standards of invention" and "sufficiency of disclosure," and which has resulted in a decline of 54% in the per capita applications for patents in the United States between 1930 and 1943, a decline in patents issued in the United States of 41½% per capita between 1933 and 1943, a decline in Court adjudications favorable to inventors, and

consequent parallel declines in the making of inventions in the United States which has, and is, reflected by concern and alarm in the public press all over the United States.

(3) General lack of uniformity of decision among the patent Tribunals below on such subjects as "invention and mechanical skill" and "sufficiency of disclosure" resulting from these so-called "doctrinal trends," resulting from alleged changes in standards of invention and sufficiency of disclosure which has resulted in a wide variation in the views of the Courts of Appeals in different Circuits on this subject varying as follows: (a) there has been such a change,* (b) there has not been such a change,** and (c)

* In *Armstrong v. United Cork*, post, Judge Clark, speaking for the Third Circuit Court of Appeals, said (p. 37):

"The Supreme Court's standard of invention (that shifting fact question) can well be thought of as the target and the efforts of the lower courts to hit it proportionately subject to the law of probable error. The high court has in recent years moved that target-standard back.

* * * * *

"We, therefore, express to them" (the inventors) "our regret for 'the sins of the past.'"

In *Chicago Steel v. Burnside Steel*, post, Judge Evans, speaking for the Seventh Circuit Court of Appeals, said (pp. 816-817):

"While this digression may not clarify the test by which invention should be measured, it may serve to reaffirm the recognized standards which throughout the past century have been applied by courts, with some degree of safety and satisfaction. *They are under severe attack today, and this discussion is to emphasize the soundness of the standards which have been applied when considering the validity of patents.*

* * * * *

"The test of 'flash of genius' has been applied to curtail the field of patentable discovery and to eliminate from the protection of patents, all products (even though they came from the superior mind of genius) which were, nevertheless, the product of prolonged study and step by step advance. *In short, it would eliminate nearly all the advances of history, in science, and in the field of mechanics.*

* * * * *

(Continued on next page.)

if there has been such a change, what is it, and where is the present anchorage,[†] as exemplified by such statements

(Continued from preceding page.)

"The test of a 'flash of genius' should be rejected not only because it is incapable of acceptable definition but because it injects into the statute something not appearing therein. *The Federal decisions covering a century contain many to the effect that it is the fact of accomplishment,—novelty appearing, rather than the method of accomplishment with which judicial inquiry is concerned.*"

In the case of *Picard v. United Aircraft Corp.*, 2 Cir., 128 F. 2d 632, 636, the court said:

"We cannot, moreover, ignore the fact that the Supreme Court, whose word is final, has for a decade or more shown an increasing disposition to raise the standard of originality necessary for a patent. In this we recognize **'a pronounced new doctrinal trend'** which it is our 'duty, cautiously to be sure, to follow, not to resist'."

** In its decision in *In Re Shortell*, *supra*, the Court of Customs and Patent Appeals said (p. 296):

"While recognizing, of course, that it is the duty of this court to follow the law as declared by the Supreme Court, *we do not conceive it to be our duty to change our basis of decision merely because some courts assume that there is a 'new doctrinal trend' with regard to the standards required for invention.*

"In our opinion it is not within the province of the courts to establish new standards by which invention is to be determined. It seems clear to us that the creation of new standards for the determination of what constitutes invention would be judicial legislation and not judicial interpretation.

"It follows, from the foregoing, that until Congress shall otherwise legislate, or the Supreme Court shall otherwise specifically hold, this court will continue to hold that if a process or thing constitutes patentable subject matter, is new and useful, and the process performed or thing produced would not be obvious to one skilled in the art, invention should be presumed and a patent may properly issue therefor."

† In *Trabon v. Dirkes*, *post*, Judge Simons said (p. 28):

"Whether in the great inventions adjudged patentable in the past the inventive concept arrived with the blinding suddenness of the lightning's flash, or from 'the projection of the imagination into the realms of the unknown,' or whether they were the product of painful and laborious experimentation apparently condemned as indicia of invention in *Picard v. Aircraft Corp.*, 2 Cir., 128 F. 2d 632, *we do not know.* Some were

as we quote *supra*, in the accompanying footnotes from such decisions as *Armstrong v. United Cork*, 107 Fed. (2) 37 (C. C. A. 3) and *In re Shortell*, 142 Fed. (2) 292 (C. C. & P. A.), *Chicago Steel v. Burnside*, 132 Fed. (2) 812, 816-818 (C. C. A. 7), and *Trabon v. Dirkes*, 136 Fed. (2) 24 (C. C. A. 6). These are typical; the number is legion.

(4) The decision of the Court of Appeals below is at variance with this Court's decisions in numerous cases ancient, intermediate and current, and ranging from the recent case of *Goodyear vs. Ray-O-Vac*, 321 U. S. 275 back to and beyond *Smith v. Goodyear*, 93 U. S. 486 on each of the following subjects:

(a) Invention is present in a new combination of elements where new advantages are realized, where the public is benefited and where there is some substantial innovations, especially when supported by objective tests. (*Loom Co. vs. Higgins*, 105 U. S. 580; *Expanded Metal vs. Bradford*, 214 U. S. 366, 381.)

(b) There is invention in change of material when new and important advantages are realized, especially when supported by the presence of objective tests. (*Smith vs. Goodyear*, 93 U. S. 486; *Goodyear v. Ray-O-Vac*, 321 U. S. 275 (See 45 F. S. 927, 931).)

Respectfully submitted,

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undoubtedly the product of accidental discovery. At least so thinks Dr. Kettering, Chairman of the National Patents Planning Commission. Certain it is that Edison placed little confidence in inspiration when he defined genius as '2% inspiration and 98% perspiration.' "



BRIEF IN SUPPORT OF THE PETITION FOR CERTIORARI.

STATEMENT OF THE CASE.

I.

The Opinions of the Courts Below: The opinion of the Sixth Circuit Court of Appeals is reported at 148 Fed. (2) 267, and appears at Vol. VI, pages 2 to 16 of the record.

The Order withdrawing the decision of certain of the issues decided by the Court and which were not before the Court appears at Vol. VI, pages 57 and 58 of the record.

The opinion of the District Court is reported at 52 F. S. 317, and appears at Vol. II, pp. 1061-1066 of the record.

Findings of Fact and Conclusions of Law of the District Court appear at Vol. II, pp. 1066-1068 of the record.

II.

(1) The jurisdiction of this Honorable Court is invoked under Section 240 (a) of the Judicial Code as amended by the Acts of February 13, 1925; 28 U. S. Code, Section 347.

(2) The date of the Decree below is March 5, 1945 (Vol. VI, R. p. 2), Petition for Rehearing was filed March 24, 1945 (Vol. VI, R. p. 17) and denied by the Court of Appeals on April 13, 1945 (Vol. VI, R. p. 57).

(3) This suit is an equity suit arising under the patent laws of the United States and the Decree of the Circuit Court of Appeals for the Sixth Circuit requires that the Bill of Complaint in the suit be dismissed on the patent cause.

III.

The Issues Are:

- (1) Invention and mechanical skill and
- (2) Sufficiency of disclosure of the first patent in suit.

IV.

Foreword: Today, in the great American invention profession, in industry, and in the patent law profession, nobody knows "where they are at," to use a colloquial, but emphatic, expression; nobody in either profession or in business, big or little, knows whether "he is afoot or on horseback," to use another such expression. The Courts below are in the same dilemmas and confusion.* No inventor knows when his grant will be validated and no lawyer knows how to advise a client. Very naturally confusion on confusion results; of this confusion about the only thing certain is that there is a very rapid and dangerous decline in invention in the United States, as we will show by data and curves hereinafter. Consequently, exercise of supervisory authority is imperative not only to still this confusion, but to stay the decline in invention and the disaster, both in peace time industry and in the war weapons, that will result therefrom.** Proceedings in the instant cause illustrate this confusion and invite the application of the supervisory authority of this Court to achieve both these ends.

* This is further well illustrated by the dissenting opinion of Judge Parker of the Fourth Circuit, sitting on the Third Circuit Court of Appeals in *Triangle v. National Electric*, 65 USPQ 197. Since the complete change in the personnel of the Third Circuit Court of Appeals, no patents have been sustained against a fair average prior thereto. The Fourth Circuit Court of Appeals has, as is clearly shown by Judge Parker's opinion, continued the previous practice. (See for example *Lever vs. Procter*, 139 Fed. (2) 633.)

** President Roosevelt's Patent Planning Commission, headed by Mr. Kettering, reported that "The American patent system" (as it was adjudicated) "stimulated American inventors to originate a major portion of the important industrial and basic inventions of the past 150 years; * * * stimulated creation and development of products and processes necessary to arm the nation and to wage successful war; * * * operated to protect the individual and small business concerns during the formative period of a new enterprise."

Confusion in the Patent Law and the Patent Practice is illustrated by such comments as those ranging all the way from a declaration by the Third Circuit Court of Appeals in *Armstrong v. United Cork, supra*, that the "standard of invention" has been raised in such a way as to be illustrated by the moving back of a target on a rifle range. So radical is the change in the view of such Court that such Court found it necessary to console the large number of inventors, patentees, etc. whose patent grants were to and have been invalidated and who would suffer as a consequence of this alleged *ex post facto* raise in the standards of invention. On the other hand, the Court of Customs and Patent Appeals in the case of *In re Shortell, supra*, finds, several years afterwards, that there has been no such change in the standards of invention, declaring that it is not within the province of the Courts to establish new standards of invention, but that that is for Congress to rule upon (142 Fed. (2) 296). Some Courts say this Court has raised the standards; others say, no, this Court hasn't. In between these extreme views we find in the other Courts, the "sound and fury" over such proposals; the "flash of genius" theory has ranged all the way from an acceptance of that theory to a rejection thereof and a reliance upon the theory of Thomas A. Edison that invention is 98% perspiration and 2% inspiration.

Disastrous Consequences of This Confusion is illustrated by the following:

(A) Decline in Decision Favorable to the Patentee Almost to the Vanishing Point and to Where the Patent Grant Is No Longer an Incentive to Invent (all done *ex post facto* after the issue of the grant): In the Sixth Circuit Court of Appeals (which may be taken as—and we think is—typical) decisions favorable to the patentee declined from over 36% in favor of the patentee in 1900 to 1905 to

less than 4% in favor of the patentee in 1944 and 1945; the following periods and percentages show the record of that Court:

Sixth Circuit Court of Appeals Record on Patents:

1900-1905	36.3%
1929-1934	35.3%
1936-1941	17.6%
1942-1945 (up to date).....	11.66%
The year ending March 21, 1945....	3.84%

We say this is typical because in some of the Courts of Appeals the old standards are maintained, while in others, such as the Third and Fifth Circuit Courts of Appeals, this decline has developed into a massacre of the inventor as shown by the following corresponding table:

1929-1934	40.3%
1936-1941	17.2%
1942 to date	0%

The same is true in the Fifth Circuit Court of Appeals whose record is as follows:

1929-1934	18.5%
1936-1941	0%

For the Ten Circuit Courts of Appeals the average record was as follows:

1929-1934	28.36%
1936-1941	17.49%

These tables are based on decisions reported in the Federal Reporter.

It is significant that most of the patents issued in 1900 and 1905 were issued by Examiners appointed under the "Spoils System" ("to the victor belongs the spoils," i.e., the Government jobs); these appointees had little or no knowledge of science and mechanics, whereas the patents before the Courts and ruled upon in 1936 to 1945 were issued by Patent Office Examiners who were graduates of technical schools and passed a rigorous Civil Service ex-

Fig. 1



Fig. 2
INVENTION INDEX 1950-1955



be seen that the trend of the invention index is generally upward, while the trend of the patent index is generally downward. This is due to the fact that the invention index is based on the number of inventions, while the patent index is based on the number of patents. The number of inventions is generally increasing, while the number of patents is generally decreasing. This is due to the fact that the number of inventions is generally increasing, while the number of patents is generally decreasing. This is due to the fact that the number of inventions is generally increasing, while the number of patents is generally decreasing.

FIG. 1

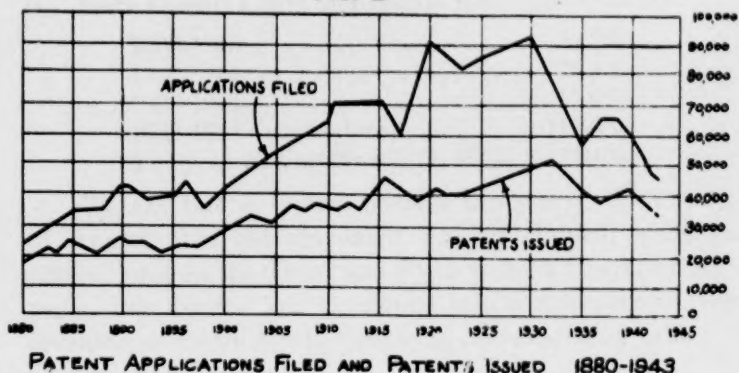
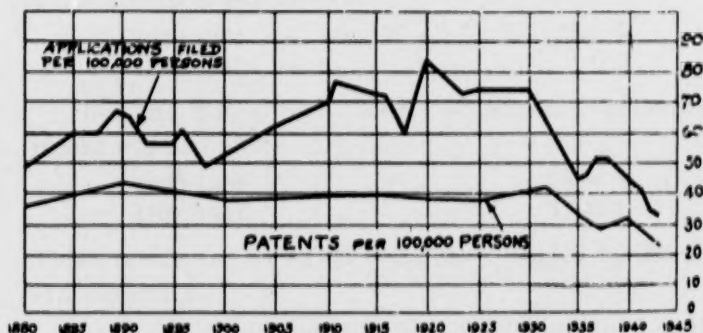


FIG. 2
INVENTION INDEX 1880-1943



IN 1880 INVENTION PER CAPITA WAS 36 PATENTS PER 100,000 PERSONS; IN 1930 IT WAS 41 PATENTS PER 100,000 PERSONS, SHOWING RATE SUBSTANTIALLY CONSTANT AND DISPROVING CLAIM THAT PATENT OFFICE HAD BECOME PATENT FACTORY. THERE WAS BETWEEN 1933 AND 1943 A DECLINE OF 41% PERCAPITA IN PATENTS. BETWEEN 1930 AND 1943 THERE WAS A DECLINE OF 54% PER CAPITA IN PATENT APPLICATIONS.

THE DATA IS FROM THE RECORDS OF THE PATENT OFFICE WHERE SUBSTANTIALLY ALL INVENTIONS ARE PATENTED.

amination relating to scientific and mechanical subjects. Therefore the higher the qualifications of the Examiners the fewer the patents sustained.

We are not contending that the decline is due to the members of the Courts, but to the confusion to which we have called attention.

(B) Decline of $41\frac{1}{2}\%$ in Per Capita Issue of Patents occurred in the United States between 1933 and 1943, as shown by the lower curve in Fig. 2 on the opposite page. This curve shows the per capita issue of patents yearly in the United States from 1880 to 1943. More specifically it shows the number of patents issued per 100,000 persons. The number of patents issued per 100,000 persons was substantially constant during this 53 years, running from 36 to 41 patents per 100,000 population. However after the beginning of the confusion to which we refer the number per capita dropped off $41\frac{1}{2}\%$ in ten years as shown by the curve.

The bottom curve in Fig. 1 shows the actual number of patents issued without regard to the population and constitutes a check on the per capita curve shown at the bottom in Fig. 2. An examination of these curves will show that the decline in the last decade was not due to depressions, to wars, to a change in attitude in the Patent Office, or to any other cause than the confusion and uncertainty and the decline in favorable adjudications of patents to which we have referred. Prior depressions, such as the 1893 depression, the 1907 depression and the 1921 depression had no effect upon the curve or the per capita issue of patents. Neither the Spanish-American War nor World War I had any effect upon either. The decline began long before the present war and continued through what is known as the "Roosevelt Prosperity." The top curve in each Fig. 1 and Fig. 2 shows the corresponding record of applications filed in the United States Patent Office and the decline in each corresponding to the recent decline in

patents shows that there was no change in the policy of the Patent Office and that the decline was due to causes outside of the Patent Office.

(C) There was a decline of 54% in the filing of applications for United States patents in the Patent Office from 1930 to 1943 on a per capita basis. This is shown in the top curve in Fig. 2. It also is checked by the top curve in Fig. 1 which shows the actual applications filed without regard to the change in population. These curves are also independent of depressions, wars, changes in policies in the Patent Office, or any other cause, except the confusion to which we have referred and the decline in adjudications favorable to patents resulting from this confusion. Both during World War I and the Spanish-American War there was an increase in the actual filing of patent applications and an increase per capita. Likewise it will be found that previous depressions had no effect upon these curves. There was little or no change during the 1893 depression, whereas there was an increase during the 1907 depression, and a slight decrease during the 1921 depression. Although the decline began in 1930, during what has been called the "Hoover Depression," it continued during the so-called "Roosevelt Prosperity" and through the prosperity resulting from World War II.

We might say that the information disclosed by this data and these curves has been circulated, has received much comment, including magazine articles and newspaper editorials in the United States, has caused much alarm and, though inviting explanations, none have been advanced which explain the curves and the data except that the falling off is due to the confusion, the hostility towards the patentee, and the increase in unfavorable adjudications.

The issue, therefore, we think, boils down to this:

Do the American people want invention to continue or not?

The decisions in the cause at bar are typical of the changes in policy which have resulted in these disastrous declines.

(D) Substantial Decline in Invention in the United States is Conclusively Established by these Records. True enough, the decline in invention may not be absolutely parallel either to the decline in patents issued or applications filed, but that both establish a substantial and dangerous decline in invention cannot be disputed. That the decline is due to causes outside of the Patent Office is clear from the decline in the applications filed. In other words, in the thirteen years between 1930 and 1943 the 54% decline in the filing of applications per capita resulted from forces and influences outside of the Patent Office.

True enough, some of the decline may be due to driving inventions "underground" and to secrecy, but that is just as disastrous as discouraging invention altogether. These causes could account for only a small part of the decline.

It will be remembered that one of the purposes of the patent grant was to prevent inventions from going "underground" and being kept secret (*Patterson v. Kentucky*, 97 U. S. 501, 507). It will also be remembered that that was one of the advantages of the patent law, as was quoted from the Supreme Court of Ohio by this Court through Mr. Justice Harlan (*Patterson v. Kentucky, supra*) in defining the conditions prior to the patent statutes:

"The ingenious man was, therefore, led either to abandon pursuits of this nature, or to conceal his results from the world. The end of the statute was to encourage useful inventions, and to hold forth, as inducements to the inventor, the exclusive use of his invention."

To common knowledge there has been a substantial return to this scheme of abandoning pursuits which would result

in invention beneficial to the public or of keeping inventions secret where possible, since these doctrinal trends adverse to the inventor and including the so-called raising of the standard of invention by some of the Courts have become current.

It is difficult to criticize the inventor of a process for resorting to secrecy and going "underground" with his process under the conditions shown by the data we have submitted for such an inventor would certainly lose his patent grant to an infringer in the Third Circuit under the currently existing attitudes and trends there as shown in the table at page 12 of this Brief. Hence, the only results of such inventor disclosing his invention in a patent would be to equip "commercial pirates" to appropriate it and subject the inventor to expensive and futile litigation.

Suppose, for example, one were to spend a large sum of money and much effort which resulted in the invention of a process for extracting aluminum from clay where it exists in abundance or to successfully extract iron from the low grade ores as we exhaust the high grade ores during the current war—would such an inventor or any one else be induced either to make such an invention or to disclose such process when with certainty one who appropriated it in the Third Circuit or the Fifth Circuit would escape with the appropriated goods? Certainly not! Yet, one of the major purposes of the patent laws and the intent of Congress was to induce inventors to disclose their inventions.

The common sense view and the inevitable conclusion is that the inventor is human, never did work for nothing, and will not work, if his grant is going to be consistently repudiated, any more than a Government employee would continue to work if his pay checks were consistently repudiated.

(E) History Affirms These Conclusions, if one needs any affirmance of the truism that people will not work if their pay checks are consistently repudiated. Since invention covers the whole range of history and almost the entire range of human activities, we will deal with the affirming history briefly here; it is divisible into four periods, as follows:

(1) The period in which there was no offer and no reward. There were very few inventions during this period—perhaps one in a century—notwithstanding efforts were made to encourage invention by other schemes, including those similar to the presently proposed Kilgore Bill scheme all of which failed.

(2) From the beginning of the 17th Century to the beginning of the 19th Century when there were patent laws, but these laws were so poorly administered that the grant was almost as consistently repudiated as currently.

(3) Beginning in the forepart of the 19th Century and running down to the forepart of the 20th Century when there was a fairer administration of the patent laws than had ever been known before. This resulted largely from the influence of Benjamin Franklin and Thomas Jefferson who were themselves inventors, and from the broad view taken by Chief Justice Marshall and his associates and reflected in such cases as *Grant v. Raymond*, 6 Peters 218, 241-243. As every living man knows, this was the golden age of inventions and more progress was made in this period of history than all the rest of human history.*

* We think this history has justified the following from Francis Bacon:

“The introduction of great inventions appears one of the most distinguished of human actions, and the ancients so considered it for they assigned divine honors to the authors of inventions, but only heroic honors to those who displayed civil merit such as the founders of cities and empires, legislators, the deliverers of their country from lasting misfortunes, the quellers of tyrants, and the like. And if any one rightly

(Continued on next page.)

(4) The current period reflected in the declining parts of the curves shown in Figs. 1 and 2 of this brief and the data submitted on page 12, showing, *inter alia*, the fortunes of the patentee in the typical Sixth Circuit Court of Appeals, and which together show that we have returned, as far as the administration of the patent law is concerned, to the situation existing during the 17th and 18th Centuries and that we are rapidly approaching the results of the few inventions made then. All of this, of course, is checked by the fact that the character of the administration of the patent law occurring in the 17th and 18th Centuries generally continued during the 19th and the early part of the 20th Centuries in such countries as Mexico, India, Spain and generally throughout the world, except the United States and Western Europe, with the result that no more inventions were made in those countries during the 19th and the early part of the 20th Centuries than were made prior thereto; in other words, the only countries in which numerous inventions were made were in the countries where there was a fair administration of a patent law and such inventions were made only in the periods of time in which there was a fair administration of a patent law.

Now the purpose of the patent laws was to increase invention; as now administered it is having the reverse effect and decreasing invention as we have proved.

We will now proceed to show that the case at bar is not only typical, but illustrative, of this change in policy from the third period to the fourth period.

(Continued from preceding page.)

compare them, he will find the judgment of antiquity to be correct; for the benefits derived from inventions may extend to mankind in general, but civil benefits to particular lands alone; the latter, moreover, last but for a time, the former forever. Civil reformation seldom is carried on without violence and confusion, while inventions are a blessing and a benefit without injuring or afflicting any."

THE CAUSE AT BAR AND ITS FORTUNES BELOW.

(1) **The Tribunals Below:** We recognize our duty to accept with sincerity and a contrite heart the integrity, the high character, the ability, the earnestness, and the sound learning in the law of the Judges in the Courts below; all this we do quite independently of any duty in the premises, but we wonder if our duty as members of the Bar require us to pay the same tribute and hold the same regard for the knowledge of these Judges in the sciences of chemistry, physics, combustion engineering, etc. involved in this present suit. We remember that forty years after General Fitzhugh Lee left West Point he said: "I studied chemistry for four years at West Point, but all I remember about it is H_2S and an awful smell." We wonder if the Judges below would claim to remember more. We suspect some of them would limit their claims to the "awful smell." Hence, we discuss first the fortunes of the applications for the patents in suit before the Patent Office Tribunals who were, and are, not only learned, but skilled in these sciences.

(a) **The Patent Office Tribunals:** Everyone familiar with the history of the Patent Office knows that beginning about the turn of the Century, only Examiners who passed a rigorous examination in science were accepted and installed in the Patent Office Examining Corps. So rigorous were these examinations that nearly everyone who passed the examination was a graduate from some technical school in some branch of engineering. Graduates of the Massachusetts Institute of Technology, of Cornell University, of Case School of Applied Science, and of other well known scientific schools were from then on commonly found upon the Examining Corps in the Patent Office until now it is rare to find any other. These Examiners were assigned in the Patent Office in the branches of the science in which they were especially skilled and educated. Those who were graduates in electrical engineering were assigned to

the electrical division, etc. The Examiners who considered the applications of the patents in suit and allowed the patents in suit were such men. There is a well established rule that a Government employee is presumed to have done his duty (*Texas v. U. S.*, 10 F. S. 198; *U. S. v. Marks*, 32 F. S. 459) which attaches in the premises. Moreover, in recent years it has been common to accept the conclusions of Boards, Commissions, etc. appointed to deal with particular subject-matter and to require their findings to be accepted as the findings of specialists by reviewing Courts whose scope of review covers the whole field of human controversies and, therefore, makes them generalists. That policy is particularly appropriate in connection with the work of the Patent Office Examiners and is reflected in such comments as are found in this Court's decisions in *Radio v. Radio*, 293 U. S. 1 and *Mumm v. Decker*, 301 U. S. 168, 171.

We recognize that these rules may be weakened where better or even where new prior art is presented in a patent cause which was not before the Patent Office. In the instant cause, however, the art selected by the defendant's expert, as well as the plaintiff's expert as most pertinent (R. pp. 604-606, 806), was before the Patent Office Examiners and not only thoroughly discussed, but thoroughly considered by them (Vol. IV, pp. 485, 547, 573, 589, and 621); the record shows, moreover, that all of the art relied upon in the Courts below was before the Examiner who allowed the patents in suit (R. pp. 644-645, 771; Vol. III, pp. 407-422), except a couple of "ragtag and bob-tail" items admittedly less important than the art before the Patent Office.

We also recognize the contention that the Patent Office Tribunals considered the questions before them *ex parte*. The futility of this contention, particularly in the instant cause, is manifested and emphasized by the fact that the salient issues were before the Patent Office in Patent Office Interferences (Vol. IV, pp. 1011-1053) and, therefore, in *inter partes* proceedings and, further, by the fact that the

principal challenge of the defendant in the instant cause to the conclusions of the Patent Office Tribunals was through a professional patent expert who was very little experienced, and not at all skilled, in the arts and sciences to which the patents in suit relate. The "qualifications" which he advanced show that he was far less learned and skilled than the Patent Office Examiners in those sciences.

(b) The District Court: We have the highest regard for the judicial and legal accomplishments of Judge Wilkin, but we doubt if he would claim to remember any more about chemistry and the other sciences involved than General Fitzhugh Lee did. Moreover, it must be remembered that he was beholden to the Court of Appeals whose record of adjudications is reported on page 12 of this brief, and whose opinions favorable to patents have declined to less than 5%. We think Judge Wilkin's findings clearly show that he thought invention was present, and his decision would have been for the patentees except for these influences.

Invention and Mechanical Skill: Judge Wilkin found the evidence upon which the Patent Office issued the patents to be supported by the objective tests and reported some of them in his opinion. Many others were established by the proof. Thus Judge Wilkin said (Vol. II, pp. 1063-1064):

"The evidence convinces the Court that there was a problem, that the plaintiff made a great contribution to the solution of the problem, and an improvement in oil burners that was accepted by the public and had commercial success. The defendant itself took a temporary license."

The record shows that this was a condensed statement of the proofs showing the presence here of all of the "objective tests" which President Roosevelt's Patent Planning

Commission recommended be made controlling on the question of invention, and which this Court has always found controlling in its decisions, ancient, intermediate and current, as noted in the quotations in the footnote below.* The evidence showed that the problem solved by the inventors of the patents in suit had long been in existence, that there were many prior efforts and failures by those skilled in the art, including the defendant's engineers, had been

* In *Goodyear v. Ray-O-Vac*, 321 U. S. 275, this Court said:

"During a period of half a century, in which the use of flash light batteries increased enormously, and the manufacturers of flash light cells were conscious of the defects in them, no one devised a method of curing such defects. Once the method was discovered it commended itself to the public as evidenced by marked commercial success. These factors were entitled to weight in determining whether the improvement amounted to invention and should, in a close case, tip the scales in favor of patentability."

In *Smith v. Snow*, 294 U. S. 1, this Court said (p. 14):

"If the matter were doubtful, it is plain from what has been said that the character of the patent and its commercial and practical success are such as to entitle the inventor to broad claims and to a liberal construction of those which he has made."

In *Expanded Metals v. Bradford*, 214 U. S. 366, 381, this Court said:

"It may be safely said that if those skilled in the mechanical arts are working in a given field and have failed after repeated efforts to discover a certain new and useful improvement, that he who first makes the discovery has done more than make the obvious improvement which would suggest itself to a mechanic skilled in the art, and is entitled to protection as an inventor."

The doctrine is neither new to nor esoteric to the patent law. On the other hand it stems from and is bottomed on the fundamental philosophy of the general law as expressed by Mr. Justice Holmes, as follows:

"The life of the law has not been logic; it has been experience."
and

"A page of history is worth a volume of logic."

made and had failed* (Vol. I, pp. 211-212; 239-242; Exs. 47, 48; 53A-53L, 54, 55, & 56), that so general was the failure that the inventors found such skepticism when the public was apprized of their success that no one would accept representations and protestations of success or adopt the inventions without first testing them out (R. pp. 96-98, 111, 217, 227, 228, 238, 944, 951). Even after success was established by test, these skeptics required the posting of bonds guaranteeing continued successful performance. General public adoption, commercial success and duplication by defendant followed (Vol. I, pp. 106, 125, 240-241; Ex. 40).

The District Court also found that a new mode of operation was present. The furnace was demonstrated to him, and he said (Vol. II, p. 740):

“I have seen it” (i.e. the new mode of operation), “if you want to leave it to me, I know what I have seen.”
(See also Vol. II, pp. 711, 722, 739-740.)

This was a new mode of operation by which the thin sheet steel member was protected from oxidization by the neutral atmosphere created through maintaining by chemical actions a carbon monoxide flame behind the thin steel member which is illustrated in Fig. 4 hereof [Report Fig. 4 of Main Brief]. “Protection from oxidation” is not to be confused with “heat resistance,” as Judge Allen unfortunately did (Circuit Court of Appeals opinion, p. 6).

Although the District Judge did not itemize the “great contribution” which he found was made by the patentees into its constituents, this protection of the then steel rim through the chemically carbon monoxide neutral-

* In decisions, ancient, intermediate and current, this Court has yielded the question of “beyond the skill of the mechanic” to history which proved that mechanics had tried and failed. (*Keystone v. Adams*, 151 U. S. 319, 144-145; *Potts v. Creager*, 155 U. S. 597, 608; *Expanded Metals v. Bradford*, 214 U. S. 366, 381; *Paramount v. Tri-Ergon*, 294 U. S. 464, 474; *Goodyear v. Ray-O-Vac*, 321 U. S. 275.)

ized atmosphere was included among the numerous advantages making up this great contribution; some others were quick heating and cooling, increase in efficiency, durability, reduction of carbon deposits, avoidance of cracking, ability to burn heavier and cheaper oils, reduction in servicing, and reduction, if not elimination, of explosions in the furnaces.

The District Court could not find the patented combinations in the prior art, but found it necessary to resort to numerous prior art devices to select elements from here and there in this prior art. This is shown in Finding No. 8 (Vol. II, p. 1067), which is as follows:

“8. Some of the features of the claimed inventions are disclosed in the Heath patent, some in the Bird patent, some in the Kolva patent, some in the Braun patent, some in Exhibit DXM, and some in Exhibit DXN, and were to the extent of such disclosure anticipated by such patents.”

and also from the following statement in the Court’s opinion (Vol. II, p. 1065):

“True, as plaintiff says, ‘there has been a change in the shape and in the size and dimensions * * * and differences in the relation to each other of the parts.’”

These were the ultimate conclusions and findings on this subject, and other comments made in the interest of brevity as to the differences must be read in the light of these quoted statements.

To invalidate a patent by selecting features from here and there in the prior art where that patent has met the objective tests and made a “great contribution” is contrary to the decisions of this Court, ancient, intermediate and current, as shown by the quotations in the footnote below.*

* In *Smith v. Goodyear*, 93 U. S. 486, this Court said (496-497):

“But where there is some such new and useful result, where a machine has acquired new functions and useful properties, it

Sufficiency of Disclosure: It must be remembered that the specifications of the three patents in suit were not only reviewed by one or more Patent Office Examiners who were learned and skilled in the subject-matter to which they relate, but they were prepared by solicitors and reviewed by the inventors who were also skilled in these arts and sciences. Therefore, to accept a conclusion that the descriptions in all three of them are indefinite and do not teach the inventions to those skilled in the art made by Judge Wilkin would be almost like accepting such a conclusion by General Fitzhugh Lee against contrary conclusions by chemists, physicists, and combustion engineers. There is no evidence in the record to support a conclusion that the specifications of all of these patents are thus indefinite. No one skilled in the art testified that they were indefinite. The furtive comments made by defendant's professional expert on this subject not only did not come from one skilled in the art, but even if construed as claiming that the disclosures were indefinite, such comments are entirely inconsistent with this expert's remarks that prior art patents, which were admittedly more meager in their disclosure, were sufficient. This latter conclusion alone shows the error of the District Judge in the premises.

Manifestly, we cannot reach the truth regarding facts by accepting the conclusions relating to science, physics,

may be patentable as an invention, though the only change made in the machine has been supplanting one of its materials by another. This is true of all combinations, whether they be of materials or processes."

In *Expanded Metal v. Bradford*, 214 U. S. 366, this Court said (p. 381):

"It is perfectly well settled that a new combination of elements, old in themselves, but which produce a new and useful result, entitles the inventor to the protection of a patent. *Loom Company v. Higgins*, 105 U. S. 580-591."

In *Goodyear v. Ray-O-Vac*, 321 U. S. 275, this Court said:

"Viewed after the event, the means Anthony adopted seem simple and such as should have been obvious to those who worked in the field, but this is not enough to negative invention."

combustion engineering, etc. made by the General Fitzhugh Lees against those made by chemists, physicists, combustion engineers and other scientists, such as the Patent Office Examiners, the inventors and their solicitors. If it is the truth we seek, there is only one choice and only one answer.

There is not a Justice on this Court who would accept an opinion of General Fitzhugh Lee, Judge Wilkin, Judge Allen, or any other lawyer, no matter how good a lawyer he or she was, which opinion was contrary to that of a chemist on a chemical question, or a medical specialist on a diagnosis in his specialty. Then why are we forced to accept conclusions of good lawyers (but at least mediocre chemists) overruling the conclusion of the Patent Office Examiners whom our Government has selected through extensive and rigorous Civil Service Examinations as specialists and experts in chemistry and the sciences and arts on questions where the evidence is the same? We would not do it if these men were members of many of the recently established boards and Commissions dealing with less involved and abstruse subjects. We would make but one choice if we were seeking advice for conducting chemical warfare, or any type of warfare to which the inventions relate. To show how far we have been led afield it is a fact that these good lawyers sustained more patents issued by those appointed as Patent Office Examiners for political reasons prior to 1900 than by the graduates of Massachusetts Institute of Technology and other technical schools currently serving as Examiners.

It is, therefore, plain that the District Court was hard put to it to render a decision which would insure his maintaining his allegiance due a Court of Appeals which was deciding 95% of its patent causes against the patentee. A fair reading of the opinion and findings of the District Court leads to two conclusions:

(1) the patents are valid on the fact findings of the District Court when applied to the established law and the decisions of this Court, ancient, intermediate and current, as late as 321 U. S., and

(2) the commendable deference of the District Judge to the practice of the Court of Appeals as shown in the table, *supra* (p. 12).

(c) **The Opinion of the Court of Appeals** was written by Judge Florence Allen. On Petition for Rehearing only the errors in the opinion which related to procedure were corrected. Judge Allen corrected the opinion to eliminate the Court's decision of issues which were not before the Court, as we have pointed out (Vol. VI, pp. 57-58). The opinion differed from the opinion of the District Court in holding indefiniteness of disclosure only in the first patent in suit and in ignoring the salient Findings of Fact of the District Court, as we understand Judge Allen's opinion. It, of course, differs from the Patent Office in holding insufficiency of disclosure in the first patent in suit and lack of invention in each of the patents in suit on the same art that was before the Patent Office.

"Insufficiency of Disclosure" in the First Patent: Judge Allen's finding of insufficiency of disclosure in this patent relating to chemistry, physics, combustion engineering, and like arts, is bottomed upon (1) an error of law that a party is required to show dimensions in his patent and (2) an error of fact that such dimensions are not shown in the patent.

The error of law is not only contrary to decisions of this Court that a patentee need not give dimensions (*Mineral Separations v. Hyde*, 242 U. S. 261, 271 and cases cited therein),* but it is emphasized by the fact that none of the

* "The composition of ores varies infinitely, each one presenting its special problem, and it is obviously impossible to

(Continued on next page.)

prior art which is relied upon to invalidate the patent gave any dimensions. The rule is well established that the requirements for the patentee are the same as those for the prior art, and the Courts do not say (except in this cause) in one breath that a disclosure in the prior art which does not show dimensions is sufficient to teach those skilled in the art, whereas a disclosure of a patent in suit which does not give dimensions is insufficient to teach those skilled in the art. Not only by common sense, but by an abundance of authority has it been held that the Courts would not say in one breath that a particular kind of disclosure in a patent was sufficient, and in the next breath that it was not.*

However, it did happen that the first patent in suit was the only patent before the Court which did give such dimensions that the dimensions of all the parts could be found by the mere use of a ruler. To require a patentee to give all the dimensions in his patent would make patent specifications endless, and would place an entirely unnecessary burden upon the patentee because those skilled in the art are capable of arriving at the dimensions, as this and other Courts have said in their opinions. Moreover, dimensions differ with sizes and often with equivalents and other factors.

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specify in a patent the precise treatment which would be most successful and economical in each case. The process is one for dealing with a large class of substances and the range of treatment within the terms of the claims, while leaving something to the skill of persons applying the invention, is clearly sufficiently definite to guide those skilled in the art to its successful application, as the evidence abundantly shows. This satisfies the law. *Mowry v. Whitney*, 14 Wall. 620; *Ives v. Hamilton*, 92 U. S. 426, and *Carnegie Steel Co. v. Cambria Iron Co.*, 185 U. S. 403, 436, 437."

* *Caewood Case*, 94 U. S. 695, 704; *Seymour v. Osborne*, 11 Wallace, 516, 555; *Downton v. Yeager*, 108 U. S. 466; *Eames v. Andrews*, 122 U. S. 40, 66; *Walker on Patents*, Deller Edition, pp. 270-272.

However, as we say, the first patent in suit gave certain dimensions as was admitted and, furthermore, these dimensions came within the limits prescribed by the experts and, therefore, complied with the strictest imaginable requirements. It was contended that the patentee did not give the dimension of the flame rim. It was, however, pointed out that in his specification he gave dimensions of other parts from which the dimension of the rim could be determined by the mere use, even by a layman, of a ruler, from which the dimension of the rim could be determined, so that if it were the law that an inventor was required to give dimensions of any part of his combination then admittedly a rim having the following minimum and maximum thicknesses is sufficient:

Minimum—.025" (Vol. VI, p. 5).

Maximum—.375" to .500" ("three-eighths of one half inch") (Vol. VI, p. 5).

Also, admittedly, the patent specification discloses the following thicknesses of rim to anybody who has the discretion to use a ruler:

.091 (Vol. VI, p. 5).

.100 (four times the thickness of .025, testified to by Mr. Powers).

.175 (seven times the preferred thickness of .025, testified to by Mr. Powers) (both recognized at the center of p. 4 of the official opinion).

Now, each of these disclosed thicknesses of .091, .100, and .175 is between the minimum of .025 and the maximum of .375 or .500. Consequently, if the rim is made .091, .100 or .175 inches in thickness, it is, by this proof, a rim which when employed in the combination disclosed would result in a structure which would be operative, useful, perform the functions of the invention and operate in accordance with the invention.

Perhaps no change of policy could be so fatal to the patent grant, and so discouraging to invention, as a change

of standard on the sufficiency of disclosure from the present and current one into one requiring the giving of dimensions in a patent, because in view of the practice established by the rule reaffirmed by this Court in *Mineral Separations v. Hyde*, *supra*, no inventor has given dimensions in his patent except by mere chance, as is the case of the first patent here in suit. Ninety-nine existing patents out of one hundred would be invalid if such were the rule, and ninety-nine out of one hundred opinions holding patents valid in the past would be erroneous. Apparently the Sixth Circuit Court of Appeals has changed, or is trending to a change, of this standard as reflected not only in the decision in this cause, but in such decisions as *Wolverine v. Detroit Gasket*, 65 U. S. P. Q. 208-209 (decided April 10, 1945, opinion by Judge Allen); *Libby-Owens v. Celanese*, 135 Fed. (2) 138 (C. C. A. 6). If we wished to stop invention in the United States we could hardly adopt a more effective rule.

The Court of Appeals in Considering Non-Invention
either differed with, or ignored, the fact findings of the District Court that the patentees had made a "great contribution to the solution of the problem" and which was "accepted" by the public, thereby establishing a finding by the District Court of a "disclosure of advances in knowledge which will be" (and here is) "beneficial to society," to quote this Court in *Sinclair v. Interchemical*, decided May 21, 1945. Judge Allen, who wrote the opinion of the Court of Appeals, concluded that the contribution made in the first patent in suit was the use of "plain steel" or "ordinary steel" in the rims of the furnace (Vol. VI, p. 9). No claim was ever made by either party and no finding was made by the District Court that this was the contribution or was even one of the contributions. Some evidence was put in on the subject merely to show that the invention was not limited to any particular kind of steel, but covered

a wide range of different kinds of steel, having different properties and, therefore, not limited to a particular kind of material since different steels are of very different materials, although they are often designated by the same name. There is a partial itemized list of the specific items which constituted the "great contribution" found by the District Court at page 3 of this brief. Indeed, all of the fact findings upon which the Court of Appeals based its conclusions were at variance with the facts upon which the District Court based its conclusions, which we have stated and quoted, *supra* (pp. 3 & 21-24). This includes the finding that the Bird patent constitutes an anticipation. The District Court found that it did no more than contribute one of the features to which there was added features from five to nine other prior devices; one providing a feature here and another a feature there which had to be united to build up anticipation in some way nobody has as yet explained, notwithstanding all our entreaties that somebody do so.

Finally the Court of Appeals ignored the finding of the District Judge that in addition to a change in materials there had been a change in shape, size, dimensions and in the relation of the parts to each other (Vol. II, p. 1065). Before the District Court came to define these differences, the District Court had noted that there was a change in material in addition to some adjustments of parts which when defined by the District Court were found to be changes "in the shape and in the size and in the dimension of the parts and differences in the relation to each other of the parts." Proceeding on the basis of this error of fact, the Court of Appeals then made an error of law in saying that it has been "uniformly held that substitution of material does not constitute invention." The true rule is, and always has been, that where a substantial contribution has been made there is invention even if the inventor did nothing more than make a substitution of materials (*Smith v. Good-year, supra*). Indeed, according to the District Court, that

was the only thing that was done in the invention in *Good-year v. Ray-O-Vac*, *supra*. (45 F. S. 927, 931.)

Thus the ruling of the Court of Appeals was based both upon an error of fact in which it differed from the District Court, and in an error of law in which it differs from this Court and many other Courts. The facts are that the patentees produced new combinations of old elements in which a feature was taken from here and a feature from there among six to ten of such old devices, whose features differed in material, in shape, in size, in dimensions and in the relation of the parts to each other, thereby making a great contribution to the solution of a problem which was adopted publicly and had commercial success.

How else can a new device differ from what went before except in materials, shapes, sizes, dimensions, and arrangements of parts, as the District Court found to be true here?

How else can an inventor make and disclose an invention which will be "beneficial to society" than to make and disclose an invention which is such a "great contribution" to the solution of a problem that it is adopted by the public and achieves the tribute of commercial success, a license and royalties from, and a duplication by the defendant?

What other proof can an inventor offer upon which his patent will be sustained than proof that his new combination differs from what went before in material, shape, size, dimensions and arrangement of parts, and that he has made a "great contribution" to the solution of a problem which has been adopted by the public, etc., all of which was found to be present in the instant cause?

Prior to the initiation of these current doctrinal trends, Courts almost universally sustained patents where the *prima facie* presumption of the validity of the patent due to its grant was supported by evidence of such facts as the District Court found to exist in the instant cause. The inventing public, the manufacturing public, and the patent

bar could depend upon these propositions. It was possible for inventors and manufacturers to proceed on that basis with their work and their investments. It was also possible for the patent bar to proceed.

We point these things out to convince this Court of the importance of doing something about this confusion, etc. to clear it up either by restoring the administration of the patent law to where it was and convince everybody that it has been so restored, or else if the Court thinks it should not be restored **to define a new basis** upon which the law is going to be administered so that the inventing and manufacturing public and the patent bar will know how to proceed.

Confusion in the Cause at Bar: Here, then, we have those skilled in chemistry, physics, combustion engineering and allied sciences who were selected by the Government because they were so skilled and qualified, and whom the law presumes did their duty, finding the disclosures in the patents in suit sufficient to teach those skilled in the art and finding the presence of invention under the rule that there was substantial innovation and beneficial contribution to society. The District Court affirms the substantial innovation and goes so far as to say that the beneficial contribution to society was a "**great** contribution" and, therefore, agrees with the Patent Office Examiner on the facts which come within the comprehension of such people as General Fitzhugh Lee.

It is not until we get into the forgotten field, that we find Judge Wilkin and Judge Allen differing from these scientific experts in the Patent Office.

Let us assume that Judge Wilkin and Judge Allen (who studied law while these experts were studying science) once knew as much about the sufficiency of disclosure of a scientific writing relating to chemistry, combustion engineering, etc. as the technical university graduates in the Patent Office. Intervening years would change that

situation in two ways: first, the Judges, like General Fitzhugh Lee, would forget much and, second, these sciences have changed materially since these Judges studied them.

It is an anomalous thing that in the administration of any branch of the law, the judiciary should agree with the scientific experts on the unscientific propositions, such as the substantial innovation and the great contribution to the benefit of the public, but should disagree with those scientists on the scientific questions of which those Judges would be prompt to say, we are certain, that they now know no more than General Fitzhugh Lee. (We do not ourselves say this of these Judges; we merely hazard the suggestion that they themselves would readily admit these propositions.)

This Court in Its Decision in *Sinclair & Carroll v. Interchemical Corporation* has, as we read the decision, made a ruling under which the patents in suit would have been sustained on the findings of the District Judge and, as we understand the decision, held that the "flash of genius" standard previously thought by many rightly or wrongly to have been set by this Court as controlling; this thought was controlling during the period in which the decisions below in the instant cause were handed down.

The "flash of genius" rule was, rightly or wrongly, read out of this Court's decision in *Cuno v. Automatic*,* and was accepted by a great many of the Courts below as the proper standard of invention, though it was subject to considerable bombardment from various sources. Be that as it may, it was controlling on the District Court in Cleveland and the Court of Appeals in the Sixth Circuit when the opinions in the instant cause were written and the issues decided. In *Sinclair & Carroll v. Interchemical*, handed down by this Court on May 21, 1945, the Court, as we read the opinion, challenged any notion that the criterion of invention was a "flash of genius" when this Court said

* 314 U. S. 84, 91.

that the Court "is not concerned with the quality of the inventor's mind, but with the quality of his product" and "whether or not those efforts" (of the patentee) "are of a special kind does not concern us." This can have no other meaning to us than that the "flash of genius" standard of invention current when the decisions below in the instant cause were rendered no longer dominates.

The proofs in the instant cause meet the requirements of invention stated by this Court in *Sinclair & Carroll v. Interchemical*. In the cited case this Court said:

"A long line of cases has held it to be an essential requirement for the validity of a patent that the subject-matter display 'invention,' 'more ingenuity * * * than the work of a mechanic skilled in the art.'" (Authorities cited.)

It would seem to be reasonable but not certain to conclude from this statement and these citations that the question of invention and mechanical skill is not to be dominated by the "flash of genius" theory. From the above quotation from this Court's opinion in the *Sinclair* case and from the citations, it seems to us reasonable to assume that a standard of invention is set which expects some substantial innovation and a substantial benefit to society. While the proofs in the instant cause do not meet the "flash of genius" test current at the time the Courts below decided the cause, they do meet the requirements set by this Court in the *Sinclair* case, as we show below.

In its opinion in the *Sinclair* case this Court said:

"This test is often difficult to apply; but its purpose is clear. Under this test, *some substantial innovation is necessary*,".

In the instant cause this test is met on the finding of the District Court that the innovation was so substantial that it differed from the prior art in every way in which one machine can differ from another when the District Judge found that the patented combination was built up from features taken from here and from there among from six

to ten prior art devices, and differed from any prior art device in the shape, size, dimensions and materials of the parts and in the differences in the relation of the parts to each other (see specific quotations from the Findings and the Opinion of the District Court on this subject, *supra*, p. 3).

The next test made by this Court in *Sinclair & Carroll v. Interchemical* was stated as follows:

“an innovation for which society is truly indebted to the efforts of the patentee.

* * * * *

“The primary purpose of our patent system is not reward of the individual but the advancement of the arts and sciences. Its inducement is directed to disclosure of advances in knowledge which will be beneficial to society;”

The District Court made Findings of Fact which report the presence of these tests when the District Court said (Vol. II, pp. 1063-1064):

“The evidence convinces the court that there was a problem, that the plaintiff made a great contribution to the solution of the problem, an improvement in oil burners that was accepted by the public and had commercial success. The defendant itself took a temporary license.”

(Vol. II, p. 1067):

“6. There was a problem and plaintiff made a contribution to the solution of the problem, an improvement in oil burners that was accepted by the public and had commercial success.”

Now, if what would appear to be the rule stated in *Sinclair & Carroll v. Interchemical* is to establish the presence of invention in the future instead of what the patent bar and the inventing public, rightly or wrongly, assumed was the “flash of genius” test, we suggest that this Court might think it well to apply the test in *Sinclair & Carroll v.*

Interchemical in enough causes to dispel the uncertainty that now exists which has resulted in the disastrous declines in inventions, patent applications and adjudications in favor of patents which have been shown in the tables and curves, *supra*. (p. 13.)

As the matter now stands it is manifest that if the "flash of genius" rule is no longer to be considered dominant, and it is still uncertain whether the old rule is restored, confusion is even greater than before since though it would seem reasonable that the "flash of genius" rule may no longer be the rule, it is not certain that the old rule is re-established and, if it is that the standard is the same, and if not what is the standard.

The cause at bar presents the questions whose decision by the Court would dispel this confusion.

The Advance in the Instant Cause Which is "Beneficial to Society":

(1) The objective proofs show, as the District Court found, that there was acceptance by the public, commercial success, and manufacture by the defendant under the patents in suit. The proofs show that there had been so many failures to produce a non-explosive wall flame oil furnace that the trade was so skeptical about the inventions of the patents in suit and the possibility of their success that the experts and the public would not accept or adopt the inventions until the abilities and virtues thereof were demonstrated to experts by tests, and even then the skepticism was so deep-rooted that the patentees were required to put up bonds to guarantee the continued successful performance. The evidence shows continued success which was limited by restrictions placed upon materials during the current wars. The record shows that the acceptance, the adoption, the commercial success, and the use by the defendant was due to the merits of the invention and to no other cause. The patentees did some little advertising

in the beginning, such as has been approved by this Court, for the purpose of announcing the contribution by the inventions and the solution of the problem (*Diamond v. Consolidated*, 220 U. S. 428). Later advertisements were necessary to meet the infringing and duplicating competition of the defendant.

(2) The subjective proofs show: Everyone is familiar with the restrictions placed upon the use of oil burners by the explosions in the burners and the dangers of such explosions. The inventions of the patents in suit eliminated such explosions or reduced them to a negligible minimum.

Cracking of the oil in the furnace was one of the objections of the old forms of furnaces, and this is eliminated in the inventions of the patents in suit.

Carbon deposits with their dangers were also eliminated.

These contributions were alone sufficient to meet the requirement of benefit to the public but, in addition, the inventions of the patents in suit increased the efficiency and the durability of the furnace and its ability to burn heavier and cheaper oils. It reduced the service charges, it increased the speed of heating and cooling, and the ability to maintain constant room temperatures.

Thus it not only made a contribution which was "beneficial to society," but it made a "*great* contribution" which was "beneficial to society"; it not only made an advance which was "beneficial to society," but it thus made a number of advances which were "beneficial to society."

Is the Test of Invention versus Mechanical Skill Any More Difficult to Apply Than Any Other Factual Question?: The following plan, based upon the facts, was generally used where reliance was had upon the facts rather than upon the "speculation of the arbitrator," to quote

Judge Altschuler in *Wahl v. Andis*, 66 Fed. (2) 164, 165 (C. C. A. 7):

The presence of mechanical skill was found when the evidence showed that a number of mechanics solved a problem simultaneously when that problem arose, as stated as follows:

"We proceed, therefore, to consider whether McElrath was entitled to a patent on the ground that he designed an important improvement in the machine used in the rayon industry which experienced persons in the industry had failed to discover, or whether, on the other hand, his design involved merely the exercise of mechanical skill. *This is a question of fact*; and since the evidence shows that *a number of persons in the industry in different parts of the country had no difficulty in effecting the desired change when the need for it became apparent*, the answer is that the change involved mechanical skill rather than invention." (Authorities cited.) (*McElrath v. Industrial Rayon*, 123 Fed. (2) 627, 629).

The presence of invention was found when the evidence showed the contrary, as stated as follows:

"It may be safely said that if those skilled in the mechanical arts are working in a given field *and have failed after repeated efforts to discover a certain new and useful improvement*, that he who first makes the discovery has done more than make the obvious improvement which would suggest itself to a mechanic skilled in the art, and is entitled to protection as an inventor." (*Expanded Metal v. Bradford*, 214 U. S. 366, 381.)

The difficulty has, it seems to us, been to induce whom Judge Altschuler called "the arbitrator" to rest his decision on the evidence on this fact question instead of resorting to "speculations."

In the cause at bar the record is replete with evidence proving a long need for the solution of the long existing problem, numerous prior efforts and failures by those

skilled in the art, including the experts of the defendant (Vol. I, pp. 211-212, 239-242; Exs. 47, 48, 53a-53-L, 54-56; Ex. 12-b, Vol. III, p. 18; Vol. I, pp. 94-95; 156 and 306).

Conclusion: Not since there was a patent law has there been such a general and destructive confusion and disagreement among different Courts. Confusion due to conflict in decisions in different Circuits on the same question, or between different Courts in the same Circuit on the same question, or due to other causes for which this Court ordinarily grants certiorari are trivial and harmless compared with that due to the causes which we point out and which are summarized as follows:

- (1) Has the standard of invention been changed?
- (2) If the standard has been changed, where is it now?
- (3) This Court should set such a standard as would insure the rules proposed by Congress of inducing people to make inventions which will benefit the public; the data and curves we have submitted prove that just the contrary is the effect of the standards currently followed by some of the Courts.

(1) If there has been no change in standard, ought not this Court to say so because the Courts below, who claim there has been a change of standard, base their decisions and rulings on the assumption that this Court has changed the standard; others claim there has been no change by this Court.

(2) If there has been a change of standard, nobody knows what is the present standard. Not only are the Courts in confusion and disagreement on this matter, but so is the Patent Bar and the inventing public. It is just as if a boat had been cut away from its anchorage and is floating down the stream without anybody knowing when or where it will be anchored. Indeed, it would seem that the boat is headed for destruction in the rapids, if it has

not already reached the rapids. Unless this Court does something about it, it is very plain from the curves and data which we have given that in not many years in the future this country will be in about the same status, as far as invention is concerned, as Mexico, Spain, India, and similar countries. Therefore, this Court ought to advise what is the new standard of invention if the old one has been changed.

(3) Even when the patent laws were construed and administered "liberally," the inducement was never more than sufficient to persuade inventors, to devote their time, money, and efforts to the making of those inventions which have been of such tremendous benefit to the public since the beginning of the last century. This is proven conclusively by the prompt decline in patent applications filed and the steady decline to 54% between 1930 and 1943 which began as soon as it became manifest that the former "liberal" administration was being withdrawn by raising the standards and by withdrawing other privileges which the patentee had enjoyed previously with respect to his patents and his inventions. Broadly speaking, therefore, the question which is before the American public, before this Court and well presented in the instant cause is—

Does the American public wish the inventor to continue to make inventions which benefited the public, including protection in war and building of industry in peace, as inventors did during these "liberal" interpretations of the patent law, or—Does the American public not wish that these inventions be continued? In other words, these curves and this data prove conclusively that inventors are very rapidly coming to the conclusion that under the patent laws as at present administered the inducement is insufficient to justify the expenditure of the inventor's time, money and effort in producing inventions which are beneficial to the public.

If further reason for this Court settling this question is needed, it is found in the Report of President Roosevelt's

Patent Planning Commission who have pointed out that industry in this country—and therefore employment by industry—is bottomed upon inventions which have been encouraged and made as a result of the patent system as it was administered prior to the time the boat was cut loose from its anchorage and, therefore, that the defense of this country in war is based upon weapons developed under the patent system as it existed before the current confusion arose.

If anyone challenges these conclusions of the Commission it is to be pointed out that our whole engineering professions, and this includes chemistry, etc., have been built up since the standards of invention were established by such men as Chief Justice Marshall at the beginning of the last century and which standards have been recently changed in a great many of the Courts, as we have pointed out. In other words, not only these useful inventions were developed under the former standards of invention, but it was during their tenure that these professions, along with the technical schools, technical journals, etc., were developed and, moreover, as President Roosevelt's Patent Planning Commission pointed out, they were developed only in the countries and only during the periods when there existed the standards of invention created by Chief Justice Marshall and his associates at the beginning of the last century.

Therefore, there could hardly be a more important question for this Court to consider and settle. Certainly there could not be, and never has been, such an important question in the patent law.

The instant cause, as we have pointed out, presents all of the requirements necessary to a settlement of these questions and issues.

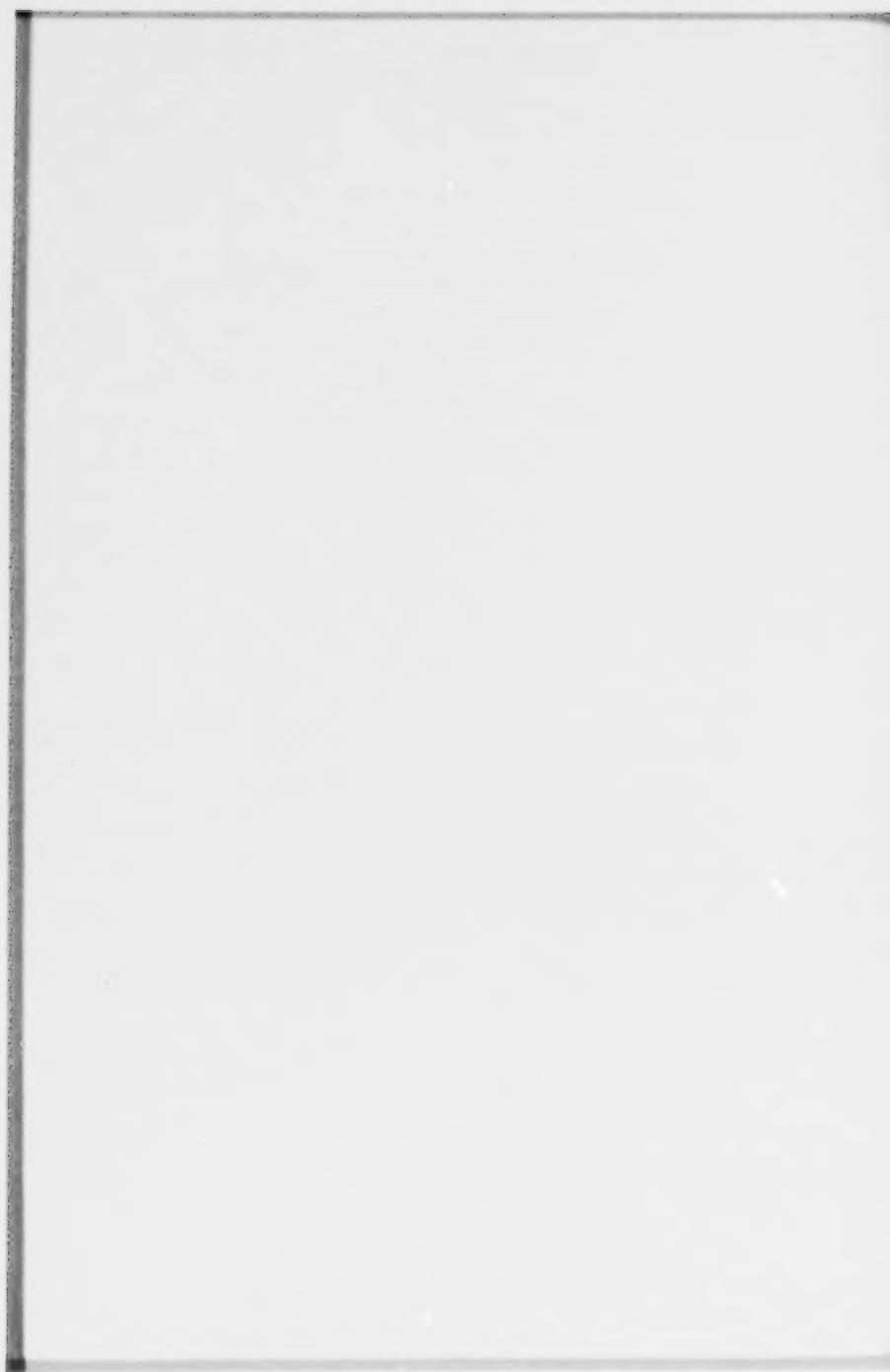
Respectfully submitted,

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IN THE
Supreme Court of the United States
October Term 1945

No. 137

THE TIMKEN-DETROIT AXLE COMPANY,
Petitioner,

vs.

CLEVELAND STEEL PRODUCTS CORPORATION,
Respondent.

**BRIEF OF RESPONDENT IN OPPOSITION TO
PETITION FOR A WRIT OF CERTIORARI.**

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New York, July 31, 1945.



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Statement of the Case.

This is an ordinary patent suit involving three patents for oil burners, No. 2,039,607 (hereinafter called '607), dated May 5, 1936. Claims 12, 14, 17, and 18 are in issue and will be found in Vol. III, 65-70; No. 2,094,764 (hereinafter called '764), dated August 5, 1937. Claims 1, 9, and 16 are in issue and appear in Vol. III, 81-85; and No. 2,107,800 (hereinafter called '800), dated February 8, 1938. Claim 9 is in issue and appears in Vol. III, 71-79.

All three of the patents in suit relate to oil burners of an old type known as a wall flame burner. District Judge WILKIN found all three of the patents invalid for insufficiency of disclosure and because anticipated by the prior art and for other reasons (Opinion, Vol. II, 1061). The Court

of Appeals (Judge ALLEN) affirmed the lower court in every respect (Opinion, Vol. VI, 2). Both lower courts were clearly right in their findings as a reading of their opinions will show. In arriving at these conclusions, the lower courts followed well-established principles of patent law and correctly applied these principles to the facts of this case. There is therefore no good reason why the petition should be granted.

Counterstatement of Matters Involved.

Contrary to Petitioner's statement, the only contested issue in this case in both courts below was that of validity of the patents in suit. The fact that defendant had a license was conceded, but this license was limited to 200 units for a specific purpose taken while the parties were trying to negotiate a general license arrangement.

Petitioner tries to complicate the case by saying that it involves chemical, physical, fuel combustion and other problems and the solution thereof. The fact is that the patents in suit all relate to simple mechanical arrangements differing if at all from the prior art only in the materials out of which certain parts were made. Petitioner tried to read into the '607 patent a special carbon monoxide flame which was not mentioned in the patent. If there are any physics or chemistry in the case they are the result of this afterthought on the part of Petitioner's attorneys.

Petitioner tries to attribute to the *patents in suit* the contribution which the Court said was made by *Petitioner*. A reading of Judge WILKIN's opinion and that of the Court of Appeals will clearly show that the contribution mentioned was said to have been made by Petitioner and not by the patents in suit.

In quoting from the findings of the District Court, Petitioner carefully avoided quoting Finding 10 reading as follows:

“The improvement over prior art was accomplished by substituting metal for ceramic material and making some adjustments of parts which are mere differences of undefined degree. It merely did better what had been done before.”

The “great contribution” which Petitioner made resided in the substitution of metal for ceramic and for the adjustments mentioned in Finding 10.

Further important facts which Petitioner fails to mention are that there are in operation today as many or more of the old ceramic burners as there are of the metal burners and that Respondent makes and sells six ceramic burners for every metal burner. Respondent makes the metal burner only for those installations where the burner and the boiler are combined into a single unit known as a “packaged job”.

There are no substantial operating advantages of the metal burner over the ceramic burner (R. Vol. I, pp. 410, 413, 414; R. Vol. II, p. 526; R. Vol. I, pp. 473-479).

Under “REASONS RELIED UPON FOR ALLOWANCE OF THE WRIT” (p. 4), Petitioner deserts and abandons the present case entirely and strikes out upon a general theme in the form of a lecture to the Court as to the decline of patents issued in the United States for a certain period of time. Petitioner attributes this decline solely to certain “Conflict and confusion among and between” the District Courts and the Courts of Appeals. There is not a word of testimony in this case even remotely relating to this subject. For all that the record shows, any decline that there might have been in the issuance of patents could have been due to the very unusual and extended depression beginning in 1930.

It is, to say the least, remarkable that this so-called "conflict and confusion" should have begun exactly at the beginning of the depression, as shown by Petitioner's curves opposite page 13. It is too obvious to require argument that such a decline could not be due entirely to the "conflict and confusion" in the courts.

There has been no conflict or confusion between the District Court and Court of Appeals in the present case. On the contrary, they have agreed on the major issue, namely, the invalidity of the three patents in suit.

Any conflict and confusion which may have existed between different courts since 1930 was between holdings of validity and invalidity in different cases where it is to be expected that there will be conflict and perhaps confusion. Such situation, however, is entirely irrelevant to this case because it is obvious that there would be conflict on the broad questions of "Sufficiency of Disclosure" and "Invention or Mechanical Skill" by different courts in different cases. This is for the very simple reason that there has not been found to date any precise and simple rule by which these questions can be resolved in every case.

Petitioner goes so far (p. 21) as to suggest that Judge WILKIN went contrary to his own views in holding the patents in suit invalid, stating that "his decision would have been for the patentees except for these influences".

It is submitted that the decisions below in this case are in complete agreement with prior decisions of this Court where similar questions have been presented on similar facts.

The only "conflict" is that between plaintiff's attorneys on the one hand and the judges of the District Court and Court of Appeals on the other hand. Such "conflict" is not

uncommon but as far as we know has never been held sufficient to grant certiorari.

The Concurrent Findings of the Lower Courts Should Not Be Disturbed.

It is a well established rule of this Court that where there have been concurrent findings of fact by lower courts, such findings will not be disturbed unless it be shown that they are clearly wrong and that there is no substantial evidence to support them. (*Continental Paper Bag Company v. Eastern Paper Bag Company*, 210 U. S. 405; *Williams Co. v. Shoe Machine Corp.*, 316 U. S. 364, 367; *Goodyear Co. v. Ray-O-Vac*, 321 U. S. 275, 278; *Universal Oil Co. v. Globe Co.*, 322 U. S. 471, 473.)

Petitioner has made no effort to show that the findings of the courts below of invalidity of the three patents in suit were not fully justified from the evidence in the case.

Petitioner's General Discussion of the Present Day Lot of the Inventing Profession and Decline in the Issuance of Patents Is Wholly Irrelevant and Immaterial.

On pages 9 to 18, inclusive, Petitioner talks in generalities about several matters which to us seem wholly irrelevant and immaterial to any issue in this case. This discussion takes the form of a delicate rebuke of this Court and of lower courts for the failure to sustain more patents. This Court is requested (p. 10) to exercise supervisory authority "not only to still this confusion, but to stay the decline in invention and the disaster, both in peace time industry and in the war weapons, that will result therefrom".

Despite a great deal of argument as to the so-called "conflict and confusion", Petitioner is silent in pointing out to the Court *how* it would be possible to "still this confusion", unless it be by sustaining every patent which is issued by the Patent Office.

It is believed that the lower courts and particularly the patent-experienced Sixth Circuit Court of Appeals understands the standards for determining invention or the lack of it. As we understand the situation, the rules and the procedure by which invention or non-invention is to be determined are no different today than they have been for the last fifty to one hundred years. The difficulty in any case is in the application of the rules to the facts of the particular case. No sane person can deny that when these rules are applied to one set of facts, invention may be found and when applied to another set, non-invention may be found. If this is the confusion about which Petitioner argues, we see no way for the Court "to still this confusion".

The argument on pages 9 to 18 are so remote from any issue in this case that further discussion of it appears to be unnecessary.

Petitioner (p. 19 and elsewhere) tries to disqualify the courts below by showing that the Judges are not scientists. With all due respect, Petitioner's argument relative to the unscientific qualifications of the lower courts applies equally to this Court. Despite this fact, Petitioner asks this Court to "still the confusion" by setting up a hard and fast rule as to what constitutes invention so that the unscientific Judges of the courts below can apply this rule to patents dealing with all phases of scientific subject matter. The burden of Petitioner's argument is that since we have Examiners in the Patent Office who are qualified to deal with the scientific questions presented to them, their decision

should be final and the Courts should sustain every patent that has been granted by the Patent Office. The difficulty with this argument is that even if the Court felt disposed to attempt to work out a rule which would allow every patent to stand, it would be in direct conflict with the statutes and would be invalid. Petitioner's efforts here should be directed to the Congress for a change in the statutes respecting all grounds upon which the validity of a patent could be attacked. This, of course, would involve a complete revamping of the entire patent system, including the Patent Office.

Petitioner gives the impression that nothing was before the Court that was not before the Patent Office. This is grossly misleading and incorrect.

Petitioner fails to point out that the Court heard testimony from experts on both sides. He had the advantage of much more evidence than was before the Examiner in the Patent Office. The Examiner's conclusions are based on an *ex parte* proceeding. It makes no difference that the '607 patent was in interference because this suit is not between the parties to the interference and the interference was decided without any contest on the question of patentability. *Bohn Aluminum & Brass Corp. v. Berry*, 124 F. (2d) 865, 867, 870 (C. C. A. 6).

Another important matter which was before the Court and not before the Patent Office was the cross examination of Mr. Powers. Still another important matter was the testimony of Mr. O'Brien. A fourth important matter was the Bird prior use. As to this, Judge ALLEN stated (Vol. VI, p. 12):

"More important than the claimed anticipation of the Bird patent we think is the fact of the Bird prior use. It is clearly established by disinterested wit-

nesses, memoranda, drawings and correspondence that Bird in 1925 built and used wall-flame burners equipped with an impingement rim of sheet metal. One was installed at the Bird house, one at the plant and two were sold. The rim was spaced a couple of inches from the wall of the water leg of the boiler."

The next sentence at this page of the record was corrected (see Vol. VI, p. 57) to read:

"This operation clearly constitutes a prior use, invalidating claims 12, 14, 17 and 18 of patent 2,039,607."

The sufficiency of disclosure is a purely legal question as to whether or not the revised statutes have been complied with. While the Patent Office Examiners may be versed as scientists, they are not particularly qualified as lawyers, some of them not having studied law at all. Since the Judges of the lower courts and of this Honorable Court have had exceptional training in the law, their judgment on legal questions is as far above that of the Examiner as Petitioner would have the Examiner's opinion above that of the Judges on scientific questions. The courts below concurred in finding that the disclosures of the three patents in suit were insufficient and we believe that this Court will agree, because the present case is strikingly similar in this respect to *General Electric Co. v. Wabash*, 304 U. S. 364 and *United Carbon Co. v. Binney & Smith*, 317 U. S. 228, cases.

Thus we see that even on the scientific questions, there was a great deal of testimony and other evidence before the lower courts which was not before the Patent Office Examiner and who knows but that he would have agreed with the Courts if the same facts had been before him. As to the sufficiency of the disclosure from a legal viewpoint and applying Petitioner's own reasoning, the opinions of the

lower courts stand far above that of the Examiner on this legal question.

Invention and Mechanical Skill.

Under this heading (p. 21), Petitioner tries to show that Judge WILKIN attributed a great contribution to the patents in suit. He did no such thing, as will be clear from a reading of his opinion. Closely following Petitioner's quotation, Judge WILKIN said (Vol. II, p. 1064):

"Yet when the specific question arises: What is the invention, what is its essence, its limits, and how is it defined, there is no adequate answer. After consideration of all the evidence and all the arguments the court finds no difference between what the plaintiff did and what was formerly done, except a change of material and the inherent mechanical variations occasioned by such changes. The improvement over prior art was accomplished by substituting metal for ceramic material and making some adjustments of parts, which are mere differences of undefined degree."

Mr. Powers, the inventor of two of the patents in suit and Petitioner's expert at the trial, admitted (Vol. I, pp. 282, 287) that every element of claim 12 of patent '607 was old in the prior art except the spaced "thin fuel vaporizing wall of high heat conductivity". The Heath patent discloses every element of every claim in suit with the single exception that the Heath construction is ceramic, whereas those of the patents in suit are of metal or other material of high heat conductivity. There is abundant evidence to support this statement. The very first entry in Powers' notebook (PX-95, Vol. III, p. 375) under date of February 23, 1932, states:

“Continuing work on *substitution** of metallic hearth tile in place of present refractory tile * * *”.

In a memorandum (PX-96, Vol. III, p. 389) prepared by Powers and sent with his letter of March 16, 1932 to his patent attorneys, Powers stated (p. 393):

“Quite some time ago a metal hearth construction was developed as a *substitute* for the present refractory hearth bed. It was my plan to *substitute* metallic segments and a metallic hearth in place of the present refractory hearth bed and refractory segments”.

When the Heath Patent 1,886,675 (Vol. IV, p. 721) is clearly understood and when it is remembered that at the time Powers developed his devices, the Petitioner owned the Heath patent, it will be evident that the substitution to which Powers made such frequent reference was substituting metal for the ceramic parts of the Heath burner.

There was nothing even novel in the use of metal in an oil burner because that is clearly shown and described in the Bird Patent 1,671,340 (Vol. IV, p. 705).

Petitioner argues (p. 24) that the District Court found it necessary to take a part from here and a part from there to anticipate the claims. This is not true. Judge WILKIN said (Vol. II, p. 1064):

“Its patents† are anticipated by Heath, 1,886,675, Bird, 1,671,340, and Kolva, 1,381,092.”

The Court of Appeals quotes at length from an interference record to which Powers was a party (Vol. VI, p. 7). From this it is clear that Powers regarded Heath as disclosing everything except “metal”. The Court of Appeals (Vol. VI, p. 11) states:

* All emphasis ours unless otherwise stated.

† It should be remembered that there are three patents in suit.

"Furthermore, this patent * is anticipated by Heath, 1,886,675, which, as stated by Powers in the interference proceedings, is for a wall-flame burner. Heath discloses all of the mechanical elements of the Powers claims, and Powers, with some hesitation, concedes this, stating that the difference is in the functioning. But the Heath burner functions in substantially the same manner as Powers."

This should be all that is necessary to show that Petitioner is in error in arguing that it was necessary for the Court in anticipating Powers to take parts from numerous sources.

The above remarks quoted from the opinion of the Court of Appeals related to the '607 patent. The only difference between that patent and Wilson '764 is that Wilson placed metal grills on the top of the flame rim. Heath clearly discloses grills and fully points out their function so that here again Wilson merely substituted metal for ceramic in so far as the grills were concerned.

The only material difference between Powers '607 patent and the Powers '800 patent is that the '800 patent has two rims, one for deflecting the air and the other as a flame rim. Heath had an air deflecting rim made of ceramic, but it functioned in exactly the same way as the Powers metal rim and therefore we have again merely the substitution of metal for ceramic.

Sufficiency of Disclosure.

In urging this defense in both courts below, we relied upon two decisions by this Court, namely, *General Electric Co. v. Wabash*, 304 U. S. 364, and *United Carbon v. Binney & Smith*, 317 U. S. 228.

* Patent '607.

The main evidence in support of this contention is that of Mr. Powers himself. It is quite clear from the '607 patent that whatever advantages are claimed for it are attributed to the thinness of the metal flame rim. It is equally evident that the patent nowhere gives any information as to how thin the rim must be. On cross examination (Vol. I, p. 263) Mr. Powers said that to gain the advantages the preferred thickness of the rim was .025 of an inch and that as this thickness was gradually increased the supposed advantages gradually disappear and that there would come a time (at about $\frac{3}{8}$ to $\frac{1}{2}$ inch) when the supposed advantages would completely disappear. He also admitted that this change, with the change in thickness, was a mere matter of degree and that there was no thickness at which there would be any kind of a critical change. Also (Vol. I, p. 266) that different materials, including metals, have different heat conductivities and that experimentation would be required for each material to determine its effective thickness. And despite the fact that cast iron is a metal and has a high heat conductivity it would not be suitable for an impingement rim (Vol. I, p. 263).

When the claims are examined it will be found that the rim is defined in very broad and general language, such as "thin", "thin sheet metal" and other similar expressions.

Petitioner tries to find sufficient disclosure by stating that the drawings of the patent are to scale. There is no statement in the patent that they are to scale.

Petitioner (p. 29) tries to show that anyone with a ruler can determine the thickness of the rim, but there is no basis for this contention. In fact the dimensions that are given in the patent do not agree. It is stated that the wall 8 in patent '607 is three or four inches from the boiler wall and that the distance *I* is about two inches. Looking at the patent drawings, the distance of the rim 8 from the boiler

wall is $\frac{3}{4}$ of an inch. If this represents three inches, then one inch on the drawing is equal to four inches. If this distance is four inches, then one inch on the drawings equals $5\frac{1}{3}$ inches.

Taking the other measurement, the distance *I* on the drawings is $\frac{11}{16}$ of an inch and if this represents two inches then one inch on the drawing equals three inches. From these calculations, using the patent drawings, we find three different values per unit or three different scales. The fact that no one of these measurements agrees with any other is conclusive proof that the drawings are not to scale.

The mere fact that the patent mentions sheet metal is of no help because Powers admitted (Vol. I, p. 279) that armor plate is sheet metal and it is well known that armor plate may be several inches thick and usually is.

In a situation like the present where whatever novelty there is depends upon the *thinness* of the flame rim, it is clear that the statute requires a definite and specific disclosure of that feature. Furthermore, the claims should be definite in order that others may know what infringes and what does not. Such a general and indefinite disclosure as we find in these patents is far below the requirements of the statutes and the patents are invalid for that reason, as both lower courts found them to be.

***Sinclair & Carroll v. Interchemical Corporation*
Is Not Helpful to Petitioner.**

Petitioner argues that this Court has changed its formula for invention by the *Interchemical* case, quoting from the decision as follows:

"Consequently it is not concerned with the quality of the inventor's mind, but with the quality of his product."

Immediately following Petitioner's quotation, this Court said:

"The patent in suit was not the product of long and difficult experimentation."

There is not a word of evidence in the present case that either Powers or Wilson did any experimentation whatsoever. For all that the record shows, Powers merely shaped a piece of metal to correspond with the face of the old ceramic segment and made up a ring of such segments, and used it with the other necessary parts, such as those used in a Heath burner. There was no special demand for any such change and no particular advantage from an operating standpoint in such change. So far as the record shows, Powers was not even requested by anyone to make the new burner, but either out of curiosity or for some other reason decided to substitute metal for the ceramic.

Petitioner admits (p. 35) that there was no flash of genius in the present case, but tries to spell out of Judge WILKIN's decision that there was some innovation that differentiated it from the prior art. As we have already explained, Judge WILKIN never said that there was any innovation in the *patents in suit*, nor did he say that the *patents* made any contribution to the art. In fact, after saying that *Petitioner* made a contribution, Judge WILKIN said that

"Yet when the specific question arises: What is the invention, what is its essence, its limits, and how is it defined there is no adequate answer."

Certainly, if Judge WILKIN could not find from the patents what the inventions were, he would not and could not say that the inventions which he could not find made a great contribution. As a matter of fact, there was no innovation and certainly none for which society is truly indebted to

the efforts of the patentees, as stated in the *Interchemical* case.

The record in this case shows that the ceramic burner was just as good as the metal burner in every respect in so far as the user was concerned and therefore neither society nor the public has been benefited materially by any contribution made by the patents in suit.

There is no difficulty whatever in the present case in applying the old established rule for determining the presence or absence of invention.

These patents are clearly insufficient in their disclosure, as settled by many cases, including the *Wabash*, *United Carbon*, and *Interchemical* cases. There is lack of invention because (1) the change is a mere matter of degree; (2) an attempt is made to repatent an old combination by improving one element thereof; (3) nothing is involved but a mere substitution of metal for ceramic and (4) the claims are invalid because anticipated.

Conclusion.

It is respectfully submitted that the petition should be denied.

New York, July 31, 1945.

NEWTON A. BURGESS,
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LLOYD L. EVANS,
Attorneys for Respondent.





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CHARLES ELMORE GROPLEY
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In the Supreme Court of the United States

OCTOBER TERM, 1945.

No. 137.

THE TIMKEN-DETROIT AXLE COMPANY,
Petitioner,

vs.

CLEVELAND STEEL PRODUCTS CORPORATION,
Respondent.

**REPLY BRIEF OF PETITIONER ON PETITION
FOR WRIT OF CERTIORARI AND REQUEST FOR
LEAVE TO FILE AND FOR CONSIDERATION OF
THE SAME.**

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NOW COMES the Petitioner and asks leave to file the attached Reply Brief and for consideration thereof.

That Confusion and Conflict between and among the Courts of Appeals, the District Courts and Judges in the same District below on the issues here involved were disclosed and established by the decisions and excerpts cited therefrom at pages 5 to 7, 10 to 11, and elsewhere in our Main Brief, is not, and cannot be, denied;* both are manifest on the face of each of these and numerous other decisions. Such conflict and confusion between and among the Courts and Judges below has always been regarded

* The statements we have made at these pages and on pages 12 to 14, and the curves opposite page 13, are based on such records as the Federal Reporter, the Federal Reporter Digests and Indices, the Reports of the Commissioner of Patents, the Census Reports, and other public records and documents, and on recent history, of which the Courts take judicial notice (*Walling v. Patton*, 134 Fed. (2) 945 (CCA 6); *Heath v. Wallace*, 138 U. S. 573, 584; *Arizona v. California*, 283 U. S. 423, 454).

by this Court as reason for granting certiorari and certiorari has been almost universally granted on more limited and less important conflicts (*Fisher v. Whiton*, 317 U. S. 217, 219; *Lilly v. Grand Trunk*, 317 U. S. 481, 483; *Miles v. Illinois*, 315 U. S. 698, 700; *Davis v. Department of Labor*, 317 U. S. 249, 254).

Certiorari Granted Where There is Conflict on the Interpretation of a Statute: The granting of certiorari is by no means limited to causes of conflict of decisions on specific questions such as the diversity of decisions on the question of whether the standard of invention has been changed, but is often granted where there is conflict on the interpretation of a statute, as is true of the patent statutes bottomed on the "invention" recited in such statutes (see for example, U. S. R. S. Sec. 4886). Indeed, all the patent statutes root back to "invention" and depend upon its interpretation. For example, in *Fisher v. Whiton*, 317 U. S. 217 this Court granted certiorari where there was such conflict, saying through Mr. Justice Murphy (p. 219):

"The Chancery Court held that petitioner's assessment claim accrued on the date first fixed for payment, May 23, 1934, and that the claim was barred by Sec. 8225 of the Tennessee Code fixing a period of 'six months from the date the cause of action thereon accrued' within which to enforce previously unmatured claims against decedents. The Court of Appeals affirmed, relying upon Sec. 8604 of the Code as well as Sec. 8225. 25 Tenn App 230, 155 SW (2d) 882. The Supreme Court of the State denied a petition for writ of certiorari. The importance of the question in the administration of insolvent national banks and a conflict with the decision in *Strasburger v. Schram*, 68 App DC 87, 93 F. (2d) 246, caused us to grant certiorari."

Certiorari Granted Where There is Baffling Confusion Among the Courts Below: The Court also grants certiorari where there is such "*confusion*" in the Courts below that counsel are unable to predict on which "side of the line" Courts or Judges will decide such questions as what constitutes invention and what not. Thus this Court in *Davis v. Department of Labor*, *supra*, speaking through Mr. Justice Black, said (p. 253):

"The very closeness of the cases cited above and others raising related points of interpretation has caused much serious *confusion*.

* * * * *

(p. 255):

"In the face of the cases referred to above, *the most competent counsel may be unable to predict* on which side of the line particular employment will fall."

It would be difficult to conceive of a situation fitting so well the pattern here described as that depicted in the multiple attitudes and interpretations in the various Circuits which we have proved exists currently (see pp. 4 *et seq.* of our Main Brief). What lawyer, patent or other kind, can predict which of the three several views adopted in the decisions cited at page 7 of our Main Brief will be adopted by any Court in the future?

The intensity of this confusion, if not its lugubriousness, is manifested by the directly conflicting views expressed in the following two opinions by two District Judges sitting in Cleveland, Ohio. The only difference is that one sits in the Court Room on the east side of the Court House and the other sits in the Court Room on the west side of the Court House.

In his opinion in the case of *Merco Nordstrom v. Acker* (unreported), No. 5771, Judge Jones, who sits in the Court Room on the western side of the Court House in Cleveland, Ohio, in holding validity of two patents said, as follows:

"Of course, the rule that the patent grant furnishes a strong evidential presumption of validity and places a heavy burden upon the challenger to overthrow it still seems to me to be safe, just, and reasonable in patent infringement suits.

* * * * *

"In this case there has been quite a lot of time devoted to the earlier art. It is quite clear that people for countless years have been endeavoring to find means or construction for preventing leakage in flow lines and also for preventing sticking of valves, and particularly when an emergency is presented, as was described in the case out west where an earthquake occurred."

(CCA opinion reported at 131 Fed. (2) 277.)

Judge Wilkin, who sits in the Court Room on the eastern side of the Court House, differs from these views, as is not only manifested by his decision in the instant cause, but in the more recent decision by him in *General Metals v. Wellman*, 57 F. S. 221 where, in rejecting the objective test and the presumption of validity based upon the grant of the Patent Office where no new art is presented, said in finding lack of invention (p. 223):

"This the conscientious judge regrets. Instinctively he prefers the exercise of objective to subjective judgment. Naturally the court is prompted by a desire to see every man rewarded for whatever contribution he has made to art or industry."

These regrets were made after citing from an opinion in the Second Circuit which holds to the view that there has been a change in the standards of invention contrary to the views in other Courts. The statement by Judge Wilkin is followed by a comment that the fundamental law must be changed in order to follow the practice followed by Judge Jones over on the other side of the Court House and by many of the Courts as shown at pages 4 and 5 of our Main Brief.

Ordinarily the confusion which baffles the prediction of competent counsel is found among Courts in different jurisdictions. Here, however, we have this confusion in the same Court House. How, for example, can counsel, competent or otherwise, predict whether his patent suit will go to the Court Room in the eastern side of the Court House at Cleveland, Ohio, or the western side? How can he advise his client, or even how can he prepare his case?

In Cleveland counsel, clients and witnesses go to the Court House on call for trial; counsel do not know until the threshold of the Court Room is reached which of these Judges will try the cause. How, then, could there be a clearer case of such confusion that counsel are "unable to predict on which side of the line" the cause will be determined, to quote Mr. Justice Black? How can counsel advise clients when counsel do not know in advance "on which side of the line" the cause will be tried? Certainly if confusion in different jurisdictions which baffle counsel is justification for granting certiorari, as was done in the cited case, then confusion even more baffling in the same Court House in the same District should justify the granting of certiorari. Indeed at the very time that the instant cause was on trial in the Eastern Court Room where the following rule was ignored, the Court in the Western Court Room handed down an opinion (unpublished) saying:

"There is, in my opinion, a heavy burden placed on the one in controversies of this character, who attacks the validity of a patent. I am inclined to adhere to the old rule that the evidential value of a patent is of sufficient importance to require pretty clear and convincing proof to overthrow that presumption." (*Whyte vs. Whyte Fly Tackle*, No. 20918.)

Certiorari is also granted "in cases of peculiar gravity and general importance or in order to secure uniformity of decision" (*Hamilton v. Wolf*, 240 U. S. 251, 258). **Here we have diversity and conflict of decisions (1) in the various**

Circuits (2) in the various Districts and (3) between different judges in different Districts.

Remedies for This Confusion and Conflict: Respondent says we suggest no remedies. If we had suggested none we think this Court would be persuaded to consider these conflicts and confusions to seek remedies, but we did suggest two remedies which have been proposed by others and followed by some of the Courts below, but not by others. In this respect our position is that of any petitioner for certiorari to settle disputes below. We ask the Court here to adopt the positions adopted and followed by one of the groups of Courts below.

The remedies and positions of certain courts below which we have suggested this Court adopt are as follows:

(1) Resort to the objective test plan suggested by Mr. Roosevelt's Patent Planning Commission* and employed by some of the lower Courts in many decisions;** and

(2) Giving the same weight to the Findings and Conclusions of the Patent Office Examiners as is ordinarily given to the Findings and Conclusions of other Boards and Tribunals created by the Government, especially since the Patent Office Tribunals are skilled in the sciences to which the inventions relate and, notwithstanding Petitioner's contention to the contrary, as skilled in the patent law as these other Tribunals are skilled in the law to which their

* On the subject of the objective test the Commission said at page 10 of its Report:

"The Commission therefore recommends the enactment of a declaration of policy that patentability shall be determined objectively by the nature of the contribution to the advancement of the art, and not subjectively by the nature of the process by which the invention may have been accomplished."

** *Wahl v. Andis*, 66 Fed. (2) 164 (CCA 7); *Chicago v. Burnside*, 132 Fed. (2) 812 (CCA 7); *Sbicca v. Milnis*, 145 Fed. (2) 389 (CCA 8).

subject-matter relates, and as skilled in the law as the Courts who sit in patent causes. Some of the Courts follow this rule (*Adler v. Wagner*, 112 Fed. (2) 264, 267 (CCA 7); *Fairbanks-Morse v. Stickney*, 123 Fed. 79, 82 (CCA 8); *Simplex v. Thacher*, 38 Fed. (2) 826, 828; *Detroit v. Burke*, 4 Fed. (2) 118, 122; *Copeman vs. General Plastics*, 140 Fed. (2) 962, 964 (CCA 7).

We recognize a reason for a different view where, and if, new and important art is offered in Court which was not before the Patent Office, but such is not true in the instant cause where the art selected by the defendant's expert as the best art before the Courts was also before the Patent Office, and where it was carefully considered by the Patent Office (Vol. II, pp. 603-606). Indeed, as we pointed out, all of the art before the Courts, except a few immaterial "rag-tags and bob-tails," was before the Patent Office. The only answer the Petitioner can make to this is to point to the conflicting expert testimony offered to the Court and whose sole design was to endeavor to furnish the Court with the technical knowledge already possessed by the Patent Office Examiners as a result of their education and training in the pertinent sciences. Often the Courts have pronounced that this conflicting expert testimony submitted to aid the lay Judge is more confusing than helpful and at least one of the District Judges below (Judge Coleman in the District of Maryland) has frequently resorted to the practice of appointing a neutral expert to relieve him from the helplessness caused by such conflicting expert testimony.

It makes no difference in the inter partes proceedings before the Patent Office that Respondent was not a party because here we are dealing with the question of comity and not with the question of estoppel by judgment.

Therefore, our proposition is not that all patents should be sustained, as Respondent contends; we have proven and do contend that in the bedlam that now exists

so few have been sustained that the disastrous results depicted in the curves opposite page 13 of our Main Brief, and explained in the pages adjacent thereto, has resulted.

Answer to the Alleged "Concurring Findings of the Lower Courts":

(a) The questions which we present here are questions of law.

(b) There is no evidence at all to support a finding of non-invention.

(c) There is no substantial evidence to support a finding of insufficiency of disclosure.

(d) There is diversity of decision between the Patent Office Tribunals and the Courts below.

(a) (1) Whether or not invention is present where the patentees have made a great contribution, solved a problem, succeeded where many others had failed, etc. (in other words, where the objective tests are present) is a question of law once the Court below has found the presence of these facts, as the District Court found and recited in his Opinion and Findings (see pp. 2-3 of our Main Brief).

(a) (2) Assuming that there had been no more than a change in materials, as Respondent contends, the question of whether or not there is invention in a change of materials is a question of law.* Once the Court has found

* In *Ray-O-Vac v. Goodyear*, 45 F. S. 927 (affirmed by this Court 321 U. S. 275), the District Court said (p. 931):

"Even substitution of metals may constitute invention where it produces a new function and the first practical success in a needed device, in which the substitution makes for increased efficiency. *Edison Electric Light Co. v. United States Electric Lighting Co.*, 2 Cir., 52 F. 300, 308."

See also *United Shoe v. Ferree*, 64 Fed. (2) 101; *Dewey v. Mimer*, 124 Fed. (2) 986; *Akme v. Aluminite*, 27 Fed. (2) 736 (C. C. A. 2); *Samson v. Sears*, 103 Fed. (2) 312 (C. C. A. 2); *Smith v. Goodyear*, 93 U. S. 486; *Potts v. Creager*, 155 U. S. 597, 608; *G. E. v. Hoskins*, 224 Fed. 464 (C. C. A. 7).

the facts to be that important results have been achieved, as the District Court found in the instant cause.

(a) (3) Whether or not there is invention in a new combination of old elements involving all of the changes possible in a machine is also a question of law* once the Court had made the fact findings that the elements of the new structure differ from the prior art in size, shape, dimensions, materials, and the relations of the parts to each other, as the District Court found below.

(a) (4) Whether or not a disclosure is sufficient to teach those skilled in the art is a question of law for the Court, and one whose determination by lawyers skilled in the art is, in our view, more to be relied upon than those not skilled in the art (*Singer vs. Cramer*, 192 U. S. 265; *Sanitary vs. Winters*, 280 U. S. 30, 50; *Solomon vs. Renstrom*, 57 F. S. 223).

(b) All of the Findings of Fact of the Courts below establish the presence of invention. These include the Lower Court's Findings of the presence of the objective tests and all the differences in structure by which machines are capable of differing from each other. Not only is there no evidence to support a contrary finding on any of these subjects, but the Court made no findings thereon to the contrary. There is, therefore, no evidence to support a conclusion that there is no invention.

(c) The only evidence to support a claim of insufficiency of disclosure is a rather furtive comment on this subject by the defendant's professional expert who by his own attempts at qualification showed that he knew less about this art than the Examiners in the Patent Office, those who prepared the patent specifications, those who reviewed them, or those who testified they were sufficient. In addition, of course, there is the partisanship of de-

* See decisions cited in the footnotes at pages 24 and 25 of our Main Brief.

fendant's professional patent expert.* There is, therefore, no substantial evidence to support the claim that the disclosures are insufficient.

(d) Since in this cause the art on the question of invention and mechanical skill before the Courts was the same as before the Patent Office and the disclosures in the patents before the two Tribunals were the same, there was diversity of decision between the Patent Office Tribunals and the lower Courts. As we have already pointed out, determination of both of these questions is, and must be, bottomed in knowledge of the science and mechanics involved in which the Patent Office Tribunals are more skilled, as cannot be disputed here.

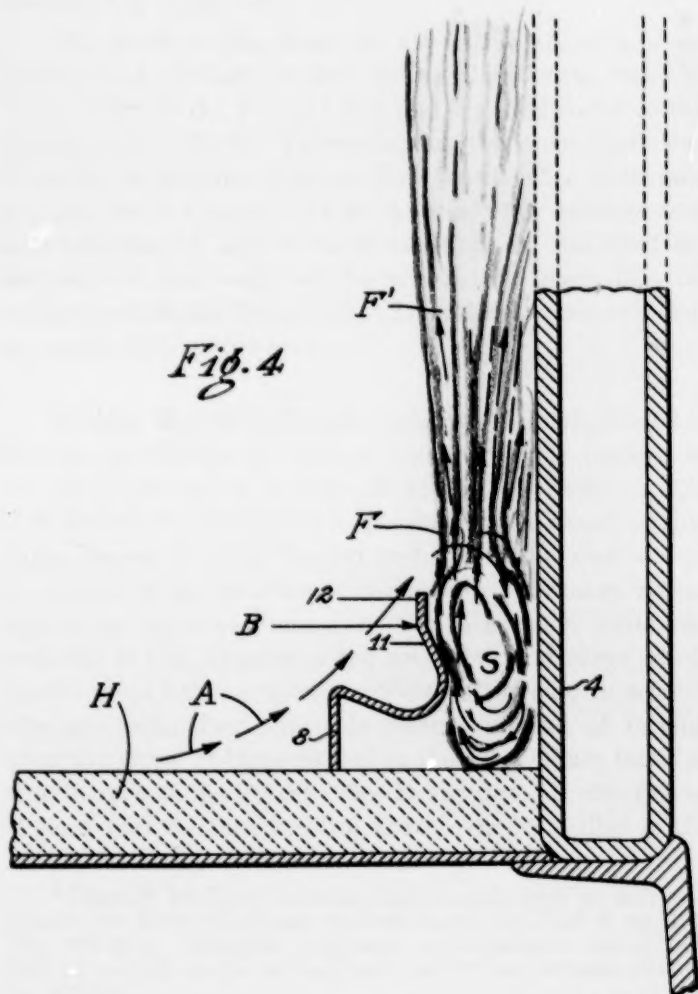
Carbon Monoxide Flame: Under well established authority the failure to mention this particular feature in the patent in suit is immaterial (*Eames v. Andrews*, 122 U. S. 40, 56).** The failure to mention this carbon monoxide flame, known to every chemist and combustion engineer to be present in the practice of the patented furnaces, as exhibited by the blue flame (see Fig. 4 hereof), while immaterial in law, illustrates the confusion and error which results from relying upon the views of laymen in science who are unfamiliar with this feature instead of relying upon the views of those skilled in the art who are familiar with it, such as the Patent Office Examiners. It also serves to show that the Patent Office Examiners are skilled in the

* Plaintiff produced practical experts each with no skill as a witness, but fully skilled and qualified in the art (Vol. I, pp. 131-132; 205-207); defendant produced a professional expert with little or no skill in the art and fully skilled as a witness (Vol. I, pp. 523-524).

** "An inventor may be ignorant of the scientific principle, or he may think he knows it and yet be uncertain, or he may be confident as to what it is, and others may think differently. All this is immaterial, if by the specification the thing to be done is so set forth that it can be reproduced." (122 U. S. 56.)



Fig. 4



rules of patent law such as those pronounced by this Court in *Eames v. Andrews*, *supra*.

No patent specification could be so complete as to instruct the layman in all of the scientific features and principles involved in such furnaces as covered by the patents in suit. The draftsman of the specification is, therefore, forced to proceed on the premise that his description is addressed to those skilled in the art and, in the instant cause, familiar with such things as the carbon monoxide flame and its presence in such furnaces; such is all the law requires.

There are many other gases and other features than the carbon monoxide inherent in the combustion of oil, all familiar to those skilled in the art (Vol. I, pp. 158-159).

To include all this known phenomena and all these operations in a patent specification would make it endless and then infringers would ask for holdings of invalidity on the grounds of prolixity.

At page 23 of our Main Brief we indicated that this operation and feature was illustrated in Fig. 4 which was to have been included in that brief but which, through an oversight, was omitted. We include it, with our apologies, opposite the present page.

The Inventors and Not the Plaintiff Made the "Contributions": In his opinion Judge Wilkin sometimes referred to the inventors as the plaintiff. This undoubtedly was because the patents in suit are assigned to the plaintiff. The contribution made, of course, was made by the inventors who made the inventions and developed the preferred embodiments disclosed in the patents in suit. The plaintiff did not make the contributions. All the evidence in the record is to the effect that the inventors made the contributions and not the plaintiff. Therefore, when Judge Wilkin said that the "great contribution" to the solution

of the problem was made by the plaintiff he was talking about the inventors. This is clear from the context.

"Making Some Adjustments of Parts," a phrase used, with other similar phrases, by the District Judge in connection with the change of materials, is indefinite as it stands. Its indefiniteness, and that of other such statements, is cleared up when construed in connection with the Judge's statement of what constituted "some adjustments of parts," or the like. This is found in the following language (Vol. II, p. 1065)

"True, as plaintiff says, 'there has been a change in the shape and in the size and dimensions * * * and differences in the relation to each other of the parts,'."

Taking Features From Multiple Prior Art Devices: Notwithstanding Respondent's sharp denial, this is what the Courts below did as Judge Wilkin said in his Findings of Facts, as follows (Vol. II, p. 1067):

"8. Some of the features of the claimed inventions are disclosed in the Heath patent, some in the Bird patent, some in the Kolva patent, some in the Braun patent, some in Exhibit DXM, and some in Exhibit DXN, and were to the extent of such disclosure anticipated by such patents."

Even when these features are selected here and there from these numerous prior art entities, there is not full anticipation, but only "*to the extent of such disclosures,*" to use the Court's words. In other words, even when the prior art is ransacked for features, and such features are picked up here and there, there still is no complete anticipation.

Conclusion: The outstanding issues raised in our Petition and Brief thereon are not disputed, as we read Respondent's Brief. These issues are that great confusion

and conflict exists in and among the Courts and other patent Tribunals below on the questions of the standard of invention* and sufficiency of disclosure; both questions are involved in the instant cause with the conflict on each subject between the Examiners in the Patent Office, who are skilled in the sciences, and the Courts below, who are not; these questions are inherently questions involving science and the patent law in which the Patent Office Examiners are also skilled, and that this confusion and conflict is so great currently that nobody knows what patent will be held to disclose invention and be sufficient and what not, with the disastrous results of a rapid decline in invention, patent applications, and patents in this country. The importance of settling these issues, and that they can be settled in the instant cause, is manifest even if all Respondent contends were correct.

Respectfully submitted,

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RICHEY & WATTS,

STRAUCH & HOFFMAN,

Of Counsel.

* The contentions on this subject range all the way from the "flash of genius" theory to the standard of "98% perspiration and 2% inspiration" attributed to Mr. Thomas A. Edison.



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CHARLES ELMORE GROPLEY
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OCTOBER TERM, 1945.

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vs.

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Respondent.

PETITION FOR REHEARING ON PETITION FOR CERTIORARI.

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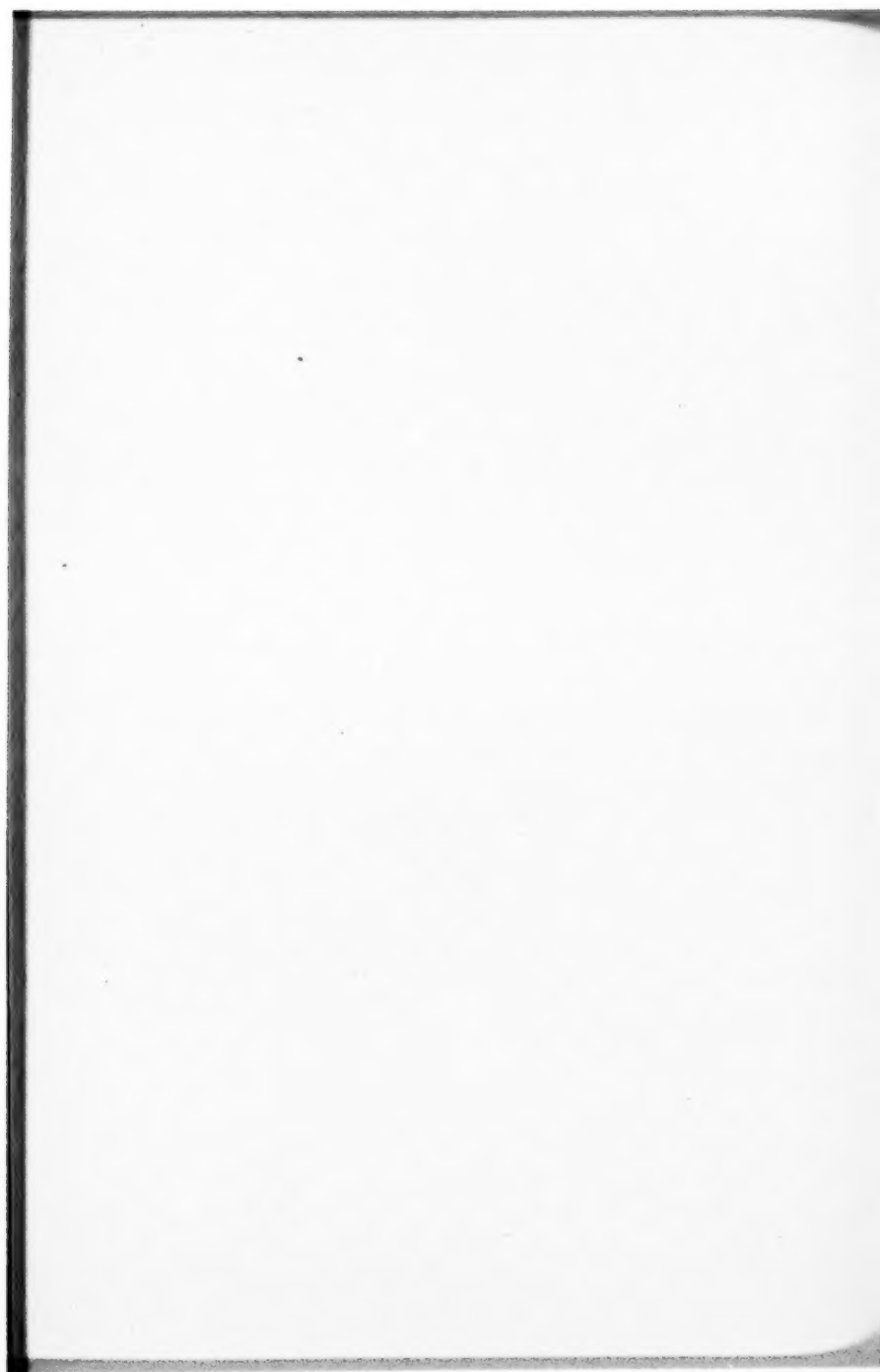
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*To the Honorable Harlan F. Stone, Chief Justice of the
United States and Associate Justices of the Supreme
Court of the United States:*

In this case, The Timken-Detroit Axle Company, filed its petition for writ of certiorari presenting four questions relating to clarification of the patent law. This petition was denied on October 8, 1945. Since the filing of the original petition for certiorari the decision of the Court of Appeals in *O'Leary v. Liggett et al.*, 66 U. S. P. Q. 219, (C. C. A. 6) has called attention to the importance of several of the points presented in the original petition and particularly to point 2 which is as follows:

“2. Confusion among all patent Tribunals below regarding such questions as ‘invention and mechanical skill’ and ‘sufficiency of disclosure’ which has arisen since the institution of certain alleged ‘doctrinal trends,’ including ‘standards of invention’ and ‘sufficiency of disclosure,’ and which has resulted in a decline of 54% in the per capita applications for patents in the United States between 1930 and 1943, a decline in patents issued in the United States of 41½% per capita between 1933 and 1943, a decline in Court adjudications

favorable to inventors, and consequent parallel declines in the making of inventions in the United States which has, and is, reflected by concern and alarm in the public press all over the United States."

We respectfully request reconsideration by this Court of this question presented by our petition for writ of certiorari. This question is an important one. What rights, if any, are given by the United States with the grant of Letters Patent for inventions? The metes and bounds of these rights are presently hidden in a fog of uncertainty. A settlement of the present confusion in patent causes will have a profound effect on the postwar future. This question should be, but has not been as yet, specifically settled by this Court.

I.

The Confusion Continues Unabated: The confusion on the questions involved in this controversy, and pointed out in our Petition for Writ of Certiorari and especially at pages 5 to 16, inclusive, thereof, have continued and no doubt the disastrous consequences of these confusions have also continued. This is shown for example by the decision of *O'Leary v. Liggett (supra)* handed down since we filed our Petition.

Here Judge Martin, who wrote the opinion for the Court, discusses the alleged changes in the standards of invention, saying:

"The patent law is presently in a state of flux."

All of this is directly contrary to what the Court of Customs and Patent Appeals said in *In re Shortell*, cited and discussed at pages 6 and 7 of our Petition for Certiorari, and all of which other Courts in other Circuits refuse to abide by even if it is true, as we also showed.

After discussing many of the former specific rules on the standards of invention, such as simplification, change

in materials, etc., Judge Martin says that a "higher standard of invention" is now required "in our Circuit," i.e., the Sixth Circuit. All of this emphasizes the diversity of practice in different Circuits upon what is probably the most important question in the whole patent law, i.e., what is invention and how is invention to be distinguished from mechanical skill?

Indeed, the diversity of views on this question in the different Courts of Appeals is so marked that the controlling question in patent litigation today is: In what Circuit will the patent be adjudicated?

II.

The records show that this Court has granted certiorari in the case of *Halliburton Oil v. Walker* (see 14 Law Week 3139 Oct. 16, 1945). An examination of the decisions in this cause (59 U. S. P. Q. 179 in the District Court and 146 Fed. (2) 817) and 149 Fed. (2) 896 in the Court of Appeals show that the point upon which certiorari was granted, i.e., the validity of one of the three patents in suit, was sustained by concurring decisions below; that is, this Court granted certiorari where there were concurring decisions holding the patent valid. The questions for the grant of certiorari there involved, though differing in phase, were similar and complementary to the same questions in the instant cause, i.e., (1) invention or mechanical skill and (2) sufficiency of description. Thus both causes involve the same general questions on concurring findings below. Thus the causes are not only parallel in issues, but in history below. The diversity of holdings, i.e. validity in the one cause and invalidity in the other, would present the opportunity of ruling on the same issues from the different sides and angles.

We point out that if the Petition for Certiorari in the instant cause were granted, the two causes, if considered in proximity to each other, would supply enough back-

ground and enough issues offered from different angles for this Court to settle these confusing differences in practice followed in the different Circuits below and check, if not stop, one way or the other, the disastrous consequences of the confusion and the changes that are going on, and at least prevent the current jockeying of the patentee and the alleged infringer to have the patent adjudicated in the Circuit most favorable to him and still the debates between the different courts of appeals on these questions.

Wherefore your Petitioner respectfully requests reconsideration of the Petition for Writ of Certiorari in this case and grant the same.

Respectfully submitted,

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I hereby certify that the foregoing Petition for Rehearing is filed in good faith and not for the purpose of delay.

F. O. RICHEY.

